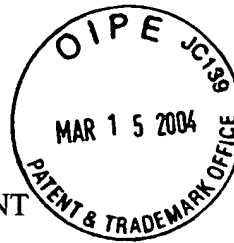


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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

CONFIRMATION NO. 6599

MICHAEL C. SCROGGIE ET AL.

US APPLICATION NO: 09/756,788

FILING DATE: January 10, 2001

GROUP ART UNIT: 3622

EXAMINER: GRAVINI

TITLE: System and Method for Providing Shopping Aids and Incentives to Customers Through
a Computer Network

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ALEXANDRIA, VA 22313

37 CFR 1.192 APPEAL BRIEF

Sir:

In response to the final office action mailed September 17, 2003, the applicants appeal.

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I. 37 CFR 1.192(a)

This brief is filed in triplicate, is accompanied by the fee set forth in 37 CFR 1.17(c), and sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

II. 37 CFR 1.192(b)

The filing is timely. Accordingly, this subsection is not relevant.

III. 37 CFR 1.192(c)

A. 37 CFR 1.192(c)(1) Real Party in Interest

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Florida corporation.

B. 37 CFR 1.192(c)(2) Related Appeals and Interferences

Appeals are pending in the following related applications:

1. US Application No.: 09/478,351, filed October 8, 2002 (Neifeld Ref.: CAT/29-SCROCO2CP). The applicants filed an appeal brief September 11, 2003. The applicants filed a response to election of species requirement, a request for reinstatement of appeal, and a supplemental appeal brief on December 22, 2003.

2. US Application No.: 09/567,274, filed May 9, 2000 (Neifeld Ref.: CAT/29-SCROCO3). The applicants filed an appeal brief January 28, 2003. The applicants filed a reply brief on October 16, 2003.

3. US Application No.: 09/716,404, filed November 21, 2000 (Neifeld Ref.: CAT/29-SCROCO4). The applicants filed an appeal brief January 29, 2003; in the absence of a response by the USPTO, the appeal brief was refiled on October 1, 2003.

4. US Application No.: 09/401,939 filed September 23, 1999 (Neifeld Ref.: CAT/29US-SCROCO). The applicants filed an appeal brief on March 14, 2003. The applicants filed a reply brief on September 17, 2003.

5. US Application No.: 09/401,198, filed September 23, 1999 (Neifeld Ref.: CAT/29US-SCROD1). The applicants filed an appeal brief on October 9, 2001. The applicants filed a reply brief July 1, 2002. The Board of Patent Appeals and Interferences assigned Appeal No. 2003-1733 on July 9, 2003.

6. US Application No.: 09/410,086, filed October 1, 1999 (Neifeld Ref.: CAT/29US-SCROD2). The applicants filed an appeal brief on July 24, 2002. The applicants filed a substitute appeal brief March 6, 2003.

7. US Application No.: 90/005,888, filed December 12, 2000 (Neifeld Ref.: SCROREEX634). This reexamination is not yet under appeal. The applicants filed an amendment in reexamination and remarks in response to the notice regarding defective paper in ex parte reexamination on April 3, 2003.

C. 37 CFR 1.192(c)(3) Status of Claims

Claims 32-91 are pending, rejected, and under appeal.

The applicants point out that the summary of the final office action mailed September 17, 2003 lists only claims 32-58 as being rejected. Office action page 2 lines 15-18. However, the body of that office action includes rejections of claims 32-91.

D. 37 CFR 1.192(c)(4) Status of Amendments

All amendments are entered.

E. 37 CFR 1.192(c)(5) Summary of the Invention

The invention of claim 32 is a system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 3 lines 12-16, page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1); and means for delivering purchasing incentives to consumers by e-mail (page 20 lines 17-19).

The invention of claim 33 is the system of claim 32 wherein said means for delivering purchase incentives delivers purchasing incentives based on consumer profile (page 19 lines 25-26).

The invention of claim 34 is the system of claim 32 wherein the consumer purchase history database and said consumer database are integrated (page 20 lines 28-29).

The invention of claim 35 is the system of claim 32 wherein said Web site is an independently administered Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 36 is the system of claim 32 wherein said Web site is a cooperative site (page 5 lines 28 through page 6 line 2).

The invention of claim 37 is the system of claim 32 wherein said consumer purchase history database includes data based on past purchasing activity (page 21 lines 4-5).

The invention of claim 38 is the system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1); and a means for delivering by e-mail notices which remind consumers to visit said Web site (page 20 lines 17-19 and page 21 lines 25-27).

The invention of claim 39 is the system of claim 38 wherein said means for delivering e-mail notices delivers notices based on consumer profile (page 19 lines 25-26).

The invention of claim 40 is the system of claim 38 wherein the consumer purchase history database and said consumer database are integrated (page 20 lines 28-29).

The invention of claim 41 is the system of claim 38 wherein said Web site is an independently administered Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 42 is the system of claim 38 wherein said Web site is a cooperative Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 43 is the system of claim 38 wherein said consumer purchase history includes data based on past purchasing activity (page 21 lines 4-5).

The invention of claim 44 is the system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20

lines 26-27, and page 20 line 29 through page 21 line 3), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1); and means for delivering by e-mail notices to purchase a specific manufacturer's product (page 20 lines 17-19).

The invention of claim 45 is the system of claim 44 wherein said means for delivering e-mail notices delivers notices based on consumer profile (page 19 lines 25-26).

The invention of claim 46 is the system of claim 44 wherein the consumer purchase history database and the consumer database are integrated (page 20 lines 28-29).

The invention of claim 47 is the system of claim 44 wherein said Web site is and independently administered Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 48 is the system of claim 44 wherein said Web site is a cooperative Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 49 is the system of claim 44 wherein said consumer purchase history database includes data based on past purchasing activity (page 21 lines 4-5).

The invention of claim 50 is the method for delivering purchasing incentives over the Internet comprising the steps of: providing a Web site which offers shopping incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); receiving a consumer's e-mail address from a consumer's computer (page 20 lines 29 through page 21 line 3); maintaining a consumer email database which can identify consumers by their e-mail address (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3); and transmitting purchase incentives via an e-mail post office (page 21 lines 4-8).

The invention of claim 51 is the method of claim 50 wherein the step of transmitting purchase incentives to the consumer by electronic mail includes transmitting purchase incentives based on a consumer profile (page 21 lines 4-19).

The invention of claim 52 is the method of claim 50 wherein the step of providing a Web site is performed by an independent Web site administrator (page 5 lines 28 through page 6 line 2).

The invention of claim 53 is the method of claim 50 wherein the step of providing a Web site is achieved cooperatively (page 5 lines 28 through page 6 line 2).

The invention of claim 54 is the method for delivering incentives over the Internet comprising the steps of: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); receiving a consumer's e-mail address from a consumer's computer (page 20 lines 29 through page 21 line 3); maintaining a consumer email database which can identify consumers by their e-mail address (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3); and transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office (page 21 lines 25-27).

The invention of claim 55 is the method of claim 54 wherein the step of providing a Web site is performed by an independent Web site administrator (page 5 lines 28 through page 6 line 2).

The invention of claim 56 is the method of claim 54 wherein the step of providing a Web site is achieved cooperatively (page 5 lines 28 through page 6 line 2).

The invention of claim 57 is a Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising: a personal database (page 22 lines 11-12); a purchase history database wherein the data on the consumer purchases are based on online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); means for generating a web page with a consumer-specific display (page 22 lines 16-18); means for updating said web page (page 20 lines 12-14 and page 23 lines 12-14); and means for informing the consumer by e-mail of new incentives (page 20 lines 2-4).

The invention of claim 58 is the method for delivery of incentives by e-mail, comprising the steps of: maintaining a consumer database which identifies consumers by their e-mail addresses; generating targeted purchase incentives from a consumer purchase history database; and formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon; and delivering the email message to an email address stored in said consumer database for said consumer (page 21 lines 4-8).

The invention of claim 59 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises shopping list selections data (page 14 lines 13-20).

The invention of claim 60 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises rebate offers data (page 12 line 21).

The invention of claim 61 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises notices detailing specific offers data (page 21 lines 27-29).

The invention of claim 62 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises focused incentives based on a consumer's prior shopping activity data (page 19 lines 25-26).

The invention of claim 63 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises purchasing incentives for data defining coupons for subsequent printing by a consumer (page 21 lines 8-10).

The invention of claim 64 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises links to at least one of manufacturer and retailer web sites (page 15 lines 18-20).

The invention of claim 65 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises data enabling a consumer to request at least one of information regarding a product and a sample of said product (page 12 line 22 and page 12 line 25).

The invention of claim 66 is the system of claim 32 wherein said consumer purchase history database stores data from any online shopping activity (page 23 lines 9-10).

The invention of claim 67 is the system of claim 32 wherein said consumer purchase history database stores an administrator of said system's web site data (page 28 lines 28-30).

The invention of claim 68 is the system of claim 32 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands data (page 6 lines 17-22 and page 23 lines 8-9).

The invention of claim 69 is the system of claim 32 wherein said consumer purchase history database stores data including at least three of said customer identification number,

name, residential address, zip code, and email address (page 14 line 27 through page 15 line 1 and page 19 lines 22-23).

The invention of claim 70 is the system of claim 32 wherein said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household (page 14 line 27 through page 15 line 1).

The invention of claim 71 is the system of claim 32 further comprising code for generating targeted, time phased incentives based on a consumer's actual buying patterns and preferences (page 21 lines 14-15).

The invention of claim 72 is the system of claim 32 further comprising code for generating untargeted incentives offered by manufacturers or retailers (page 21 lines 14-15).

The invention of claim 73 is the system of claim 32 wherein said purchase incentives contain data enabling coupons to be printed by said consumer (page 21 lines 8-9).

The invention of claim 74 is the system of claim 32 wherein said purchase incentives contain data enabling purchase incentives to be printed at point of sale (page 24 lines 21-24).

The invention of claim 75 is the system of claim 32 further comprising means to encode in a consumer's identification card, tokens representing said purchase incentives (page 24 lines 9-12).

The invention of claim 76 is the method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises shopping list selections associated with a particular consumer (page 14 lines 13-20).

The invention of claim 77 is the method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises rebate offers data associated with a particular consumer (page 12 line 21).

The invention of claim 78 is the method of claim 50 wherein said online shopping activity stored in said consumer purchase history database in association with an identification for a particular consumer comprises data detailing notice of specific offers provided to said particular consumer (page 21 lines 27-29).

The invention of claim 79 is the method of claim 50 further comprising generating focused incentives for a consumer based on said consumer's prior shopping activity (page 19 lines 25-26).

The invention of claim 80 is the method of claim 50 further comprising generating purchasing incentives data in a form suitable for printing of a coupon by a consumer (page 21 lines 8-10).

The invention of claim 81 is the method of claim 50 further comprising generating links to at least one of manufacturer and retailer web sites and associating said links with a particular consumer (page 15 lines 18-20).

The invention of claim 82 is the method of claim 50 further comprising enabling a consumer to request at least one of information regarding a product and a sample of a product (page 12 line 22 and page 12 line 25).

The invention of claim 83 is the method of claim 50 wherein said consumer purchase history database stores data from an administrator of said system's web site (page 28 lines 28-30).

The invention of claim 84 is the method of claim 50 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands (page 6 lines 17-22 and page 23 lines 8-9).

The invention of claim 85 is the method of claim 50 wherein said consumer purchase history database stores at least three of said customer identification number, name, residential address, zip code, and email address (page 14 line 27 through page 15 line 1 and page 19 lines 22-23).

The invention of claim 86 is the method of claim 50 wherein said consumer purchase history database stores selected consumer demographic information, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household (page 14 line 27 through page 15 line 1).

The invention of claim 87 is the method of claim 50 wherein said purchase incentives include targeted, time phased incentives based on a consumer's actual buying patterns and preferences (page 21 lines 14-15).

The invention of claim 88 is the method of claim 50 wherein said purchase incentives include untargeted incentives from at least one of manufacturers and retailers (page 21 lines 14-15).

The invention of claim 89 is the method of claim 50 further comprising printing said purchase incentives on a printer connected to and controlled by a consumer's computer (page 21 lines 8-9).

The invention of claim 90 is the method of claim 50 further comprising printing purchase incentives at point of sale (page 24 lines 21-24).

The invention of claim 91 is the method of claim 50 further comprising encoding in a consumer's identification card tokens representing said purchase incentives (page 24 lines 9-12).

F. 37 CFR 1.192(c)(6) Issues

Whether the rejections of claims 32-91 under the first paragraph of 35 USC 112 are improper and should be reversed.

Whether the rejections of claims 32-91 under the second paragraph of 35 USC 112 are improper and should be reversed.

Whether the rejections of claims 32-91 under 35 USC 102 based upon Jovicic et al. (US 5,855,007) [hereinafter Jovicic] are improper and should be reversed.

Whether the rejections of claims 32-91 under 35 USC 103(a) based upon the examiner's alleged personal experience with PerformanceBike are improper and should be reversed.

Whether the final rejections of claims 32-91 under the judicially created doctrine of obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469, claims 1-39 of U.S. patent No. 6,014,634, and claims 1-10 of U.S. Patent No. 6,185,541 are improper and should be reversed.

G. 37 CFR 1.192(c)(7) Grouping of Claims

Group 1 consists of claims 32, 33, 68, 69, and 73. Group 2 consists of claim 34. Group 3 consists of claim 35. Group 4 consists of claims 38 and 43. Group 5 consists of claim 39. Group 6 consists of claim 40. Group 7 consists of claim 41. Group 8 consists of claim 42. Group 9 consists of claims 44 and 49. Group 10 consists of claim 45. Group 11 consists of claim 46. Group 12 consists of claim 47. Group 13 consists of claim 48. Group 14 consists of claims 50, 79, 80, 84, 85, and 89. Group 15 consists of claim 51. Group 16 consists of claim 52.

Group 17 consists of claim 53. Group 18 consists of claim 54. Group 19 consists of claim 55. Group 20 consists of claim 56. Group 21 consists of claim 57. Group 22 consists of claim 58. Group 23 consists of claims 59 and 76. Group 24 consists of claims 60 and 77. Group 25 consists of claims 61 and 78. Group 26 consists of claims 62 and 79. Group 27 consists of claims 63 and 80. Group 28 consists of claims 64 and 81. Group 29 consists of claims 65 and 82. Group 30 consists of claims 66 and 83. Group 31 consists of claims 67 and 84. Group 32 consists of claims 70 and 86. Group 33 consists of claims 71 and 87. Group 34 consists of claims 72 and 88. Group 35 consists of claims 74 and 90. Group 36 consists of claims 75 and 91. Group 37 consists of claim 37. Group 38 consists of claim 36.

H. 37 CFR 1.192(c)(8) Argument

1. 37 CFR 1.192(c)(8)(i) - First Paragraph 35 USC 112

a. The Rejections Under 35 USC 112 of Claims 32-91

1. The Examiner's Argument

In support of the rejections of claims 32-91 under 35 USC 112, first paragraph, the examiner stated that:

Claims 32-58 [sic] are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The independently claimed steps of a system and method of a web site for providing purchasing incentives from multiple sources or a consumer database which can identify consumers by their e-mail addresses, wherein the consumer database is connected to the web site so as to receive consumer data from the web site are not enabled from the specification, because the specification does not discuss these system and method features such that one skilled in the art would be reasonably conveyed of inventor possession of the claimed invention. The specification merely recites vague language and general concepts but not the claimed details by the applicants. Since claims 33-37, 39-40, 45-49, 51-53, 55-56, and 59-91 depend upon claim[s] 32, 38, 44, 50, 54, and 57 which recite the independently claimed non-enabling new matter features, those claims are also rejected as being non-enabling new matter from the independent parent claim. Furthermore, claims 32, 33, 38, 39, 44, 45, and 57 contain recitations invoking 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). Those claims contain means for language which is not construed means-plus-function language under the rubric of reasonable interpretation, because the [sic] neither the claims nor specification provides a clear limit of

patentability. Those claimed means are merely exemplified after the “for” recitation and may incorporate any function that could be taught in the prior art. In order to consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter. It is requested that applicants specify the opportunity and obligation whether to invoke 35 USC 112, sixth paragraph for claims 32, 33, 38, 39, 44, 45, and 57. In order to consider that claim in light of the prior art, examiner will assume that those claims are enabling to those skilled in the art and contain a clear limitation under the broadest reasonable interpretation. [Office action mailed September 17, 2003 page 2 line 5 through page 3 line 11.]

2. The Applicants’ Response

In reply, the applicants submit that these rejections are improper and should be reversed because there is no factual basis supporting the legal conclusion that any one of claims 32-91 violate the first paragraph of 35 USC 112.

The examiner’s reasoning confuses enablement and written description requirements, so the applicant addresses both issues below.

a. Claims 32-91 are Enabled

The enablement rejections of claims 32-91 are improper for two reasons.

First, the examiner has provided no facts or reasoning supporting a conclusion that programming of web sites was not within the level of skill of one of ordinary skill in the art as of the middle of the 1990s.

Second, the subject matter of the claimed inventions relates to programming of web sites. Web site computer programming in particular, and computer programming in general, were well known in the early 1990s. It has long been the law that mere implementation in computer code of specified functions is within the skill of one of ordinary skill in the art. See for example the CCPA’s relevant holding in In re Sherwood, which stated that:

In assessing any computer-related invention, it must be remembered that the programming is done in a computer language. The computer language is not a conjuration of some black art, it is simply a highly structured language. . . . The conversion of a complete thought (as expressed in English and mathematics, i.e. the known input, the desired output, the mathematical expressions needed and the methods of using those expressions) into a language a machine understands is necessarily a mere clerical function to a skilled programmer. [In re Sherwood, 613 F.2d 809, 817, n. 6, 1980 CCPA LEXIS 298, n. 6, 204 USPQ 537, 544 n. 6 (CCPA 1980).]

Since claims 32-91 specify functions implemented in computer code, these claims are enabled. Therefore, the rejections of claims 32-91 are improper and should be reversed.

b. Claims 32-91 are Described in the Specification

i. Support for “a web site for providing purchasing incentives from multiple sources”

There is written description support for the independent claim limitation “a web site for providing purchasing incentives from multiple sources” at page 18 lines 21-29 of the specification. Page 18 lines 21-29 of the specification states that:

An alternative arrangement for distributing purchasing incentives over the Internet is illustrated in FIG. 13. This figure shows an incentive distribution server computer 300 and a user’s personal computer 302 connected together through a computer network, indicated by the network cloud 304. The server 300 has an associated storage device 306 on which are stored multiple advertisements and promotions. The system as described thus far operates in much the same way as the system described above with reference to FIGS. 1-11. A user 308 logs on to the server 300 through the network 304 and selects from a variety of offers stored on the storage device 306 by *manufacturers and retailers*.

Specifically, the language “A user . . . selects from a variety of offers stored on the storage device 306 by *manufacturers and retailers*” supports the claimed language “purchasing incentives from multiple sources”.

In addition, applicants refer to page 3 lines 12-16 of the specification, which states that:

The purchasing incentive offers in the presently preferred embodiment of the invention are derived from two sources: product manufacturers and retailers. The manufacturers’ incentives are presented to the customer in the form of a convenient index that the customer can browse through and select from. Similarly, retail supermarkets provide the source of another set of special offers, organized by store.

Specifically, the language “The purchasing incentive offers . . . are derived from two sources: product *manufacturers and retailers*”, in the context of users’ selections from a web site, supports the claimed language “purchasing incentives from multiple sources”. Therefore, the rejections of claims 32-91 are improper and should be reversed.

ii. **Support for “a consumer database which can identify consumers by their e-mail addresses”**

a. **Page 15 lines 3-10**

There is written description support for the independent claim limitation “a consumer database which can identify consumers by their e-mail addresses” at page 15 lines 4-10. Page 15 lines 4-10 of the specification states that:

FIG. 9 shows the registration process, which is similar to the Log-in process of FIG. 2, and identical reference numeral are used where appropriate. During the registration process, the customer's E-mail address is verified for correct syntax, as shown in block 90. The first time the customer registers, the E-mail address is used to create a unique household identification (id.), as shown in blocks 230 and 232. Subsequently, the user's household id. is used to reference prior registration information. The next steps are to record or update the consumer information, as indicated in block 234, and to proceed to final list generation, as indicated in block 236.

This passage teaches that during registration, the customer's e-mail address is verified and is then used to create a unique household identification number. When the customer subsequently logs in, the system uses the customer's household identification to reference prior registration information, thereby identifying consumers by their e-mail addresses.

b. **Page 20 line 26 - page 21 line 3**

There is also written description support for the independent claim limitation “a consumer database which can identify consumers by their e-mail addresses” at page 20 line 26 - page 21 line 3. Page 20 line 26 - page 21 line 3 of the specification states that:

The system administrator also maintains a consumer database 506, which identifies consumers by their E-mail addresses. Alternatively, the consumer database 506 may be integrated with the consumer purchase history database 502. The consumer database 506 receives data primarily from the system administrator's Web site, indicated at block 508, which, in turn, receives a consumer's E-mail address from each consumer's computer, indicated at 510. The consumer database 506 may also receive E-mail addresses from independent consumer E-mail address lists, indicated in block 512.

This passage teaches that the consumer's e-mail address is captured by the system administrator's Web site, which receives the e-mail address from each customer's computer (510). Page 20 lines 26-27 disclose that the system stores consumers' e-mail addresses in the consumer database (506). Page 21 lines 1-3 teaches that the consumer database may also receive

e-mail address information from independent consumer e-mail address lists.

iii. **Support for “wherein the consumer database is connected to the web site so as to receive consumer data from the web site”**

There is written description support for the independent claim limitation “wherein the consumer database is connected to the web site so as to receive consumer data from the web site” at page 20 line 29 - page 21 line 1. Page 20 line 29 - page 21 line 1 of the specification states that:

The consumer database 506 receives data primarily from the system administrator’s Web site, indicated at block 508, which, in turn, receives a consumer’s E-mail address from each consumer’s computer, indicated at 510.

This passage specifically provides support for the independent claim limitation “wherein the consumer database is connected to the web site so as to receive consumer data from the web site” because the consumer’s e-mail address is an example of consumer data, and this passage discloses that the consumer database receives the consumer’s e-mail address from the web site.

In view of both the lack of clarity in the rejections and the express showing of support for claim limitations just presented, the applicants submit that the rejections of claims 32-91 are improper and should be reversed.

c. **35 USC 112 Sixth Paragraph Rejections of Claims 32, 33, 38, 39, 44, 45, and 57**

The applicants respectfully submit that these rejections are improper and should be reversed.

First, 35 USC 112, sixth paragraph does not define a requirement with which the applicant must comply. Therefore, it is not a section of the statute which can form the basis for a rejection.

Second, the means for sending email delivered by claims 32, 33, 38, 39, 44, 45, and 57 are well defined since the term “email” is well defined in the art. Therefore, claims 32, 33, 38, 39, 44, 45, and 57 are definite.

Third, generating and operating web pages are well defined phrases in the art. Therefore, claim 57 is definite. Therefore, however construed, the rejections of claims 32, 33, 38, 39, 44, 45, and 57 are improper and should be reversed.

2. 37 CFR 1.192(c)(8)(ii) - Second Paragraph 35 USC 112

a. The Rejections Under 35 USC 112 of Claims 32-91

1. The Examiner's Argument

In support of the rejections of claims 32-91 under 35 USC 112, second paragraph, the examiner stated that:

Claims 32- 58 [sic] are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of a system and method of a web site for providing purchasing incentives from multiple sources or a consumer database which can identify consumers by their e-mail addresses, wherein the consumer database is connected to the web site so as to receive consumer data from the web site fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the claims do not provide an antecedent basis for those features. Since the claims do not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the claims such that it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since claims 33-37, 39-40, 45-49, 51-53, 55-56, and 59-91 depend on claim[s] 32, 38, 44, 50, 54, and 57 which recite the independently claimed indefinite feature, those claims are also rejected as being indefinite from the independent parent claim. Furthermore, claims 32, 33, 38, 39, 44, 45, and 57 contain recitations invoking 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). Those claims contain means for language which is not construed means-plus-function language under the rubric of reasonable interpretation, because the [sic] neither the claims nor specification provides a clear limit of patentability. Those claimed means are merely exemplified after the "for" recitation and may incorporate any function that could be taught in the prior art. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter. It is requested that applicants specify the opportunity and obligation whether to invoke 35 USC 112, sixth paragraph for claims 32, 33, 38, 39, 44, 45, and 57. In order to consider those claims in light of the prior art, examiner will assume that those claims are not definite and contain non-indefinite subject matter. [Office action mailed September 17, 2003 page 3 line 12 through page 4 line 17.]

2. The Applicants' Response

In reply, the applicants disagree for several reasons.

First, the claim recitations are clear on their face, even without any reference to the specification. Therefore, their rejection as indefinite is improper and should be reversed.

Second, there is almost ipsus verbis antecedent basis support for the subject claim recitations in the specification, and the subject claim recitations are clearly supported by the specification's recitations. See page 12 lines 11-17, page 15 lines 4-10, page 20 lines 17-19, and page 20 line 25 - page 21 line 3.

Third, the examiner's reference to lack of antecedent basis misapplies the law because the relevant recitations do not purport to refer to prior claim recitations. For example, claim 32's recitation "a Web site for providing purchasing incentives from multiple sources", is identified by the examiner as lacking antecedent basis, and, of course, it needs no antecedent basis.

For all of the foregoing reasons, the rejections of claims 32-91 as indefinite are improper and should be reversed.

Finally, the applicants do not understand the examiner's "opportunity and obligation" recitation, and submit that the Board should ignore it.

3. 37 CFR 1.192(c)(8)(iii) - 35 USC 102

a. The Rejections Under 35 USC 102(b) of Claims 32-91 Based upon Jovicic

1. The Examiner's Argument

In support of the rejections of claims 32-91 under 35 USC 102(b), the examiner stated that:

Claims 32-58 [sic] are rejected under 35 USC 102(b) as being anticipated by Jovicic et al. (US 5,855,007). Jovicic discloses a system or method comprising:

a web site for providing purchasing incentives from multiple sources (see the first sentence of the abstract whereby the internet and coupon is considered patentably equivalent to the claimed web site and incentives respectively);

a consumer purchase history database based on consumer online shopping activity (the internet coupon server in the second sentence of the abstract is considered patentably equivalent to the claimed online consumer purchase history database);

a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site (the unique internet coupon generation process transmitting a coupon back to a user's e-mail storage in the third and fourth sentences of the abstract is considered patentably equivalent to the claimed e-mail address consumer identification for web connection to receive consumer data); and

means for delivering purchasing incentives to consumers by e-mail (the

unique internet coupon generation process transmitting a coupon back to a user's e-mail storage in the third and fourth sentences of the abstract is considered patentably equivalent to the claimed e-mail address consumer delivery). In other independent claims, the recited features including reminding consumers, specific manufacture products, e-mail database or post office, personal database, and targeting incentives are statements of intended use and are also anticipated by Jovicic. Furthermore, the dependently claimed features, including the amended matter in the newly added thirty-one claims are also considered statements of intended use also anticipated by Jovicic. [Office action mailed September 17, 2003 page 5 line 4 through page 6 line 5.]

2. The Applicants' Response

(a) Jovicic is not 102(b) Prior Art

The following is a quotation of 35 USC 102(b):

A person shall be entitled to a patent unless the invention was patented or described in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Jovicic (US 5,855,007) was published after December 29, 1998. The present application claims benefit of the filing date of U.S. Application Serial Number 09/401,939, filed September 23, 1999, which is a continuation of Application Serial Number 08/905,501 filed August 4, 1997, which is a continuation of PCT Application Serial Number PCT/US96/20497 filed December 23, 1996. Since the present application is a continuation of PCT application PCT/US96/20497, the specifications are identical, and therefore, all of the claims supported by the present application are also supported by PCT application PCT/US96/20497. Since claims 32-91 are supported by the specification of this application, they are prima facie entitled to the effective filing date of December 23, 1996. In re Wertheim, 646 F.2d 527, ___, 209 USPQ 554, 565-66 (CCPA 1981). Therefore, Jovicic is not 102(b) prior art. Therefore, the rejections of claims 32-91 under 102(b) are improper and should be reversed.

Moreover, the examiner has not shown that Jovicic discloses what is claimed at least for the reasons presented below.

(b) The Examiner has not Shown that Jovicic Discloses a System or Method Comprising "a web site for providing purchasing incentives from multiple sources"

The examiner stated that "Jovicic discloses a system or method comprising: a web site for providing purchasing incentives from multiple sources". In support of this statement, the

examiner parenthetically referred to “the first sentence of the abstract whereby the internet and coupon is considered patentably equivalent to the claimed web site and incentives respectively”.

In reply, the applicant notes that the first sentence in the Jovicic abstract only states that:

An electronic coupon communication system for generating and redeeming unique product discount coupons over public computer networks such as the Internet.

That sentence does not disclose the limitations defined by the claim recitation “a web site for providing purchasing incentives from multiple sources”. Thus, the examiner has not carried his burden of persuasion.

**(c) Jovicic does not Disclose a System or Method
Comprising “a consumer purchase history
database based on consumer online shopping
activity”**

The examiner stated that “Jovicic discloses a system or method comprising: a consumer purchase history database based on consumer online shopping activity”. In support of this statement, the examiner parenthetically stated that “the internet coupon server in the second sentence of the abstract is considered patentably equivalent to the claimed online consumer purchase history database”.

In reply, the applicant notes that the second sentence in the Jovicic abstract only states that:

The system comprises a first Internet node, an Internet coupon server and an Internet coupon notification center.

This passage and any corresponding disclosure in Jovicic do not disclose “a consumer purchase history based on consumer online shopping activity” as recited, for example, by claim 32. Instead, Jovicic discloses, with respect to databases, only that the user inputs demographic information during the initial registration process. See column 9 lines 60-63, which states that:

Field 5 [Defined as “User demographic information” in Table 2 in Jovicic column 9 line 48.] bears indicia identifying user’s demographic information which the Internet Coupon Server receives from the user during the initial registration process. [Jovicic column 9 lines 60-63.]

Moreover, the examiner’s position here is apparently inconsistent with his position as to the teachings of Jovicic in related reexamination Control No: 90/005,888. In the office action

mailed May 14, 2002, in that reexamination, the examiner admitted that Jovicic does not disclose updating the product data stored in a purchase history database, stating that:

The independently claimed *purchase incentive depending on product data stored in said personal page database and page data updating* is patentably distinct from Jovicic because the purchase incentive or coupon depends on “product data” or “page data,” which is further updated, neither of which is expressly or implicitly taught in Jovicic. At column 3 lines 1-6, Jovicic discusses a coupon distribution and redemption system based on already obtained demographic data.¹ [Page 4 lines 10-16; italics in the original; underlining and bold added for emphasis.]

Thus, the examiner’s assertion in this application that Jovicic does disclose updating “product data” in a consumer information database is inconsistent with his admission in the reexamination that Jovicic does not disclose updating “product data”.

Moreover, Jovicic’s teachings clearly indicate that Jovicic does not disclose (1) a consumer purchase history database (2) based on consumer online shopping activity.

As an example, consider the object of the invention, column 3 lines 1-6 in Jovicic, which states that:

[T]o provide a coupon distribution and redemption system which can identify users of the system before they make coupon selections and offer different coupons to different users of the system before they make coupon selections on the basis of already-obtained demographic data about the users.

Thus, Jovicic is clearly directed to providing coupons, not purchases. Jovicic discloses demographic information in the user database 126 based solely upon the initial registration process. Jovicic’s demographic information is not purchase history information. Therefore, Jovicic does not disclose a consumer purchase history database.

Moreover, Jovicic does not disclose “consumer online shopping activity”. Therefore, Jovicic does not disclose “a consumer purchase history database based on consumer online shopping activity”, as recited, for example, by claim 32.

Independent claims 32, 38, 44, 50, and 54 all recite “a consumer purchase history database based on consumer online shopping activity”. Jovicic does not disclose “a consumer purchase history database based on consumer online shopping activity”.

¹Attachment 10 is a copy of page 4 of the office action mailed May 14, 2002 in reexamination number 90/005,888.

Independent claim 57 recites “a purchase history database wherein the data on the consumer purchases are based on online shopping activity”. Jovicic does not disclose “a purchase history database wherein the data on the consumer purchases are based on online shopping activity”.

Independent claim 58 recites “generating targeted purchase incentives from a consumer purchase history database”. Jovicic does not disclose “generating targeted purchase incentives from a consumer purchase history database”.

Therefore, Jovicic does not disclose the subject matter defined by independent claims 32, 38, 44, 50, 54, 57, and 58.

All of the dependent claims in the subject application depend from one of the foregoing independent claims. At least for these reasons, the rejections of claims 32-91 as being anticipated by Jovicic are improper and should be reversed.

(d) **Jovicic does not Disclose a System or Method Comprising “a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site”**

The examiner stated that “Jovicic discloses a system or method comprising: a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site”. In support of this statement, the examiner parenthetically stated that “the unique internet coupon generation process transmitting a coupon back to a user’s e-mail storage in the third and fourth sentences of the abstract is considered patentably equivalent to the claimed e-mail address consumer identification for web connection to receive consumer data”.

- In reply, the applicant notes that the third and fourth sentences in the Jovicic abstract only state that:

The Internet coupon server generates a unique Internet coupon using a coupon generation process. The Internet coupon server accepts an on-line selection of one of the available unique Internet coupons from a user of the Internet node and transmits the coupon back to the user’s printing device or e-mail storage.

This passage and any corresponding disclosure in Jovicic do not disclose “a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site” as recited, for example, by claim 32. Instead, Jovicic discloses, with respect to email addresses, only that the user may be prompted to enter an email address and the Internet Coupon Server 124 mails the coupon electronically to the user. See column 8 lines 2-17, which states that:

For example, user input accepted through the keyboard 114 can step through, or browse through the available electronic coupons in the Internet Coupon Server's browsing memory 128 during an on-line session and by having the Internet Coupon Server 124 sequentially transmit digitized pattern of the electronic coupon over public computer network such as the Internet 122, to Internet node's 102 output device, such as the display 116. **Once the user viewing the display 116 selects an electronic coupon 300 being displayed, such as by entering user input at the keyboard 114, the Internet Coupon Server 124 may ask the user to choose if the coupon is to be mailed electronically, Internet Coupon Server 124 prompts the user to input an electronic mail address 418. When electronic mail address is inputted [sic], Internet Coupon Server 124 mails the coupon electronically to the addressee 420.** [Jovicic column 8 lines 2-17; emphasis added.]

Jovicic does not disclose retaining an email address in a consumer database. Therefore, Jovicic does not disclose “a consumer database which can identify consumers by their e-mail address. Furthermore, Jovicic does not disclose “a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site”, as recited, for example, by claim 32.

Independent claims 32, 38, 44, and 58 all recite “a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said web site so as to receive consumer data from said web site”. Jovicic does not disclose “a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said web site so as to receive consumer data from said web site”.

Independent claim 50 recites “a consumer email database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site”. Jovicic does not disclose “a consumer email database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site”.

Independent claim 54 recites “a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site”. Jovicic does not disclose “a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site”.

Therefore, Jovicic does not disclose the subject matter defined by independent claims 32, 38, 44, 50, 54, and 58.

All of the dependent claims in the subject application depend from one of the foregoing independent claims. At least for these reasons, the rejections of claims 32-56 and claims 58-91 as being anticipated by Jovicic are improper and should be reversed.

4. 37 CFR 1.192(c)(8)(iv) - Rejections Under 35 USC 103(a) of Claims 32-91 Based upon the Examiner’s Personal Knowledge of the Organization “Performance Bike”

a. The Rejections Under 35 USC 103(a) of Claims 32-91

1. The Examiner's Argument

In support of the rejections of claims 32-91 under 35 USC 103(a), the examiner stated that:

Claims 32-58 [sic] are rejected under 35 USC 103(a) as being unpatentable over an obvious variation of examiner’s personal experience of consumer purchasing incentive distribution provided by PerformanceBike. Since at least 1994, PerformanceBike has performed the claimed method and system of providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer shopping activity;
a consumer database which can identify consumers by their addresses, wherein said consumer database can receive consumer data; and any one of means for delivering purchasing incentives to consumers,
means for delivering notices to purchase a specific manufacturer’s product,
transmitting purchase incentives via post office, and
means for or a method informing of new incentives or printing coupons. It is also considered old and well known that the claimed consumer profile basis, purchase history database either independently administered or of a cooperative form, and where purchase history includes data based on past purchasing activity are part of a system and method of delivering incentives. Official notice is taken of these old and well known claimed steps because specifically:
a consumer profile basis results in different incentives for a given

consumer profile (e.g. an incentive delivery to a PerformanceBike customer who strives to be a Tour de France competitor rather than one who desires a new tricycle for a younger family member is a key element of a consumer profile basis,

a purchase history database either independently administered or of a cooperative form results marketing mailings and where purchase history includes data based on past purchasing activity (e.g. homeowners are often targeted with offers of home mortgage refinancing, home improvements such as roofing, gutter cleaning, or window replacement based on their past purchase of a home or when a tricycle purchase results in offers of children products such as child helmets, tricycle horns, tricycle bells and the like).

The claimed providing purchasing incentives from multiple sources occur when the examiner went into a PerformanceBike retail outlet store and viewed incentive discounted products from a sales catalog source or another source such as a seasonal promotional pamphlet separate from the sales catalog. The claimed consumer purchase history database based on consumer shopping activity occurs when the examiner became a member of Team Performance which is a frequent buyer program and submitted demographic data. The claimed consumer database which can identify consumers by their addresses, wherein said consumer database is connected so as to receive consumer data is considered equivalent to the examiner submitting data as a Team Performance member to PerformanceBike in order to provide shipping information such that the examiner Team Performance members is identified by the member address which is connected to a PerformanceBike database such that PerformanceBike mails Team Performance members seasonal sales information on a periodic basis. The independently claimed steps including means for delivering purchasing incentives to customers, means for delivering notices to purchase a specific manufacturer's product, transmitting purchase incentives via post office, and means for or a method informing of new incentives or printing coupons were administered by PerformanceBike through consumer purchasing incentives sale mailings which included manufacturer product coupons of products available either at the retail outlet to examiner postal mailing address. The examiner experience discussed above teaches the invention except for the claimed web site or page, online interaction, or e-mail communication. It would have been obvious to one skilled in the art to provide the claimed web site or page, online interaction, or e-mail communication since web site or page, online interaction, or e-mail communication are merely automated features of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art). It is considered that the claimed web site or page, online interaction, or e-mail communication are broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result as discussed under examiner experience as a Team Performance member. The motivation to combine applicants claimed

invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities through electronic mail mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention. [Office action mailed September 17, 2003 page 6 line 7 through page 9 line 6.]

2. The Applicants' Response

In reply, the applicants respectfully submit that these rejections are not supported by substantial evidence and they fail to carry the burdens of proof and persuasion. Therefore, the rejections of claims 32-91 are improper and should be reversed.

a. The Examiner has not Met his Burden of Showing Prima Facie Obviousness Under 35 USC 103(a)

Specifically, the examiner stated that:

It would have been obvious to one skilled in the art to provide the claimed web site or page, online interaction, or email communication since web site or page, online interaction, or e-mail communication are merely automated features of a concept that is old and well known as discussed above. [Office action mailed September 17, 2003 page 8 lines 14-17.]

The examiner has not met his burden for obviousness under 35 USC 103(a) for claims 32-91. Regarding the requirements for a showing of obviousness, in McGinley v. Franklin Sports, Inc., the CAFC stated that:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. [McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).]

In In re Rouffet, the CAFC stated that:

In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. [In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).]

In reference to the examiner's burden in showing the requisite motivation, in In re Sang-Su Lee, the CAFC stated that:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this

combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. [In re Sang-Su Lee, Docket No. 00-1158 (Fed. Cir. January 18, 2002).]

The examiner has not met his burdens of proof and persuasion for obviousness under 35 USC 103(a) for claims 32-91 because the examiner has not shown the requisite factual basis and reasoning for motivation to modify the prior art in a manner that results in claimed subject matter. The examiner has failed to show sufficient motivation why it would have been obvious to modify "a concept that is old and well known" to arrive at the claimed inventions. Each claim defines more than a website, an email, or an online transaction. The examiner's blanket conclusions do not address the limitations claimed, and therefore fail the requirement to show motivation. In re Rouffet, *infra*. Therefore, the rejections of claims 32-91 under 35 USC 103(a) are improper and should be reversed.

b. The Examiner's Admission that Examiner's Experience Does not Teach the Claimed Web Site or Page, Online Interaction, or E-mail Communication

On page 8 lines 12-13 of the office action mailed September 17, 2003, the examiner, in support of rejections of claims 32-58, alleged that his experience teaches the inventions claimed in the subject application, except for the claimed web site or page, online interaction, and e-mail communication. In that passage, the examiner stated that:

The examiner experience discussed above teaches the invention except for the claimed web site or page, online interaction, or e-mail communication.

However, as shown below, the actual facts specified by the examiner regarding what he knew to be prior art do not support his assertion above. The applicants submit that the facts regarding prior art alleged by the examiner were insufficient to have made the subject matter of any claim obvious to a person of ordinary skill in the art. Thus, the examiner's assertions do not support rejection under 35 USC 103(a) of any one of claims 32-91. Therefore, the rejections should be reversed.

**i. The Examiner's Identification of Facts
Comprising His Knowledge of Prior Art**

The examiner's alleged experience specified at office action mailed September 17, 2003 page 7 line 15 to page 8 line 12 identifies only the following facts as his knowledge of prior art:

1. The examiner viewing "incentive discounted products in papers available in a PerformanceBike retail store".
2. The examiner joining "Team Performance".
3. The examiner "submitted demographic data".
4. The examiner impliedly receiving "seasonal sales information" from PerformanceBike.

a. Claim 32 Limitations

The examiner does not actually identify any of the limitations defined by independent claim 32. With respect to claim 32, the examiner does not identify as his prior art knowledge:

1. A system for delivering incentives over the Internet;
2. a web site for providing purchasing incentives from multiple sources;
3. a consumer purchase history database based upon online shopping activity;
4. a consumer database which can identify consumers by their e-mail addresses;
5. a consumer database that is connected to and receives consumer data from a web site;
6. means for delivering purchasing incentives to consumers by e-mail.

b. Claim 38 Limitations

The examiner does not actually identify any of the limitations defined by independent claim 38. With respect to claim 38, the examiner does not identify as his prior art knowledge:

1. A system for delivering incentives over the Internet;
2. a web site for providing purchasing incentives from multiple sources;
3. a consumer purchase history database based upon online shopping activity;
4. a consumer database which can identify consumers by their e-mail addresses;
5. a consumer database that is connected to and receives consumer data from a web site;
6. means for delivering by e-mail, notices which remind consumers to visit the web site.

c. Claim 44 Limitations

The examiner does not actually identify any of the limitations defined by independent

claim 44. With respect to claim 44, the examiner does not identify as his prior art knowledge:

1. A system for delivering incentives over the Internet;
2. a web site for providing purchasing incentives from multiple sources;
3. a consumer purchase history database based upon online shopping activity;
4. a consumer database which can identify consumers by their e-mail addresses;
5. a consumer database that is connected to and receives consumer data from a web site;
6. means for delivering by e-mail, notices to purchase a specific manufacturer's product.

d. Claim 50 Limitations

The examiner does not actually identify any of the limitations defined by independent claim 50. With respect to claim 50, the examiner does not identify as his prior art knowledge:

1. A method for delivering incentives over the Internet;
2. providing a web site which offers shopping incentives from multiple sources;
3. maintaining a consumer purchase history database based upon online shopping activity;
4. receiving a consumer's e-mail address from a consumer's computer;
5. maintaining a consumer database which can identify consumers by their e-mail addresses;
6. transmitting purchase incentives via an e-mail post office.

e. Claim 54 Limitations

The examiner does not actually identify any of the limitations defined by independent claim 54. With respect to claim 54, the examiner does not identify as his prior art knowledge:

1. A method for delivering incentives over the Internet;
2. providing a web site which offers shopping incentives from multiple sources;
3. maintaining a consumer purchase history database based upon online shopping activity;
4. receiving a consumer's e-mail address from a consumer's computer;
5. maintaining a consumer database which can identify consumers by their e-mail addresses;
6. transmitting to customers, via the consumer's e-mail post office, a notice to visit the web site.

f. Claim 57 Limitations

The examiner does not actually identify any of the limitations defined by independent claim 57. With respect to claim 57, the examiner does not identify as his prior art knowledge:

1. A web site for providing information and shopping incentives from multiple sources, such as retailers and manufacturers comprising a personal database;
2. a purchase history database wherein the data on the consumer purchases are based on online shopping activity;
3. means for generating and updating a web page with a consumer-specific display;
4. means for informing the consumer by e-mail of new incentives.

g. Claim 58 Limitations

The examiner does not actually identify any of the limitations defined by independent claim 58. With respect to claim 58, the examiner does not identify as his prior art knowledge:

1. A method of delivery of incentives by e-mail, comprising maintaining a consumer database which identifies consumers by their e-mail addresses;
2. A method of delivery of incentives by e-mail, comprising maintaining a consumer database which generates targeted purchase incentives from a consumer purchase history database;
3. formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon;
4. delivering the email message to an email address stored in said computer database for said consumer.

ii. The Examiner's Allegations do not Support Rejection under 35 USC 103(a) of any one of Claims 32-91

On page 8 line 20 through 9 line 6 of the office action mailed September 17, 2003, the examiner alleged that:

It is considered that the claimed web site or page, online interaction, or e-mail communication are broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result as discussed under examiner experience as a Team Performance member. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to (sic) allow advertisers greater consumer targeting capabilities through electronic mail mediums, while transferring electronic

information, which clearly shows the obviousness of the claimed invention.

This statement does not indicate why all limitations claimed in any claim are disclosed or suggested by the prior art. Therefore, it cannot support rejection of any claim.

Moreover, the applicants assert that the examiner's allegation that his experience teaches the inventions claimed in the subject application, except for the claimed web site or page, online interaction, and e-mail communication are insufficient to support a rejection under 35 USC 103(a) of any of claims 32-91, because each of the independent claims in the application (32, 38, 44, 50, 54, 57, and 58) defines additional limitations.

The independent claims recite numerous limitations not even alleged by the examiner as known to him.

a. Claim 32 Recitations not Alleged by the Examiner

Independent Claim 32 recites:

A system for delivering incentives over the Internet comprising:

- a Web site for providing purchasing incentives from multiple sources;
- a consumer purchase history database based on consumer online shopping activity;
- a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

means for delivering purchasing incentives to consumers by e-mail.

b. Claim 38 Recitations not Alleged by the Examiner

Independent Claim 38 recites:

A system for delivering incentives over the Internet comprising:

- a Web site for providing purchasing incentives from multiple sources;
- a consumer purchase history database based on consumer online shopping activity;
- a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

a means for delivering by e-mail notices which remind consumers to visit said Web site.

c. Claim 44 Recitations not Alleged by the Examiner

Independent Claim 44 recites:

A system for delivering incentives over the Internet comprising:

- a Web site for providing purchasing incentives from multiple sources;
 - a consumer purchase history database based on consumer online shopping activity;
 - a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and
- means for delivering by e-mail notices to purchase a specific manufacturer's product.

d. Claim 50 Recitations not Alleged by the Examiner

Independent Claim 50 recites:

A method for delivering purchasing incentives over the Internet comprising the steps of:

- providing a Web site which offers shopping incentives from multiple sources;
 - maintaining a consumer purchase history database based on consumer online shopping activity;
 - receiving a consumer's e-mail address from a consumer's computer;
 - maintaining a consumer email database which can identify consumers by their e-mail address; and
- transmitting purchase incentives via an e-mail post office.

e. Claim 54 Recitations not Alleged by the Examiner

Independent Claim 54 recites:

A method for delivering incentives over the Internet comprising the steps of:

- providing a Web site which offers shopping incentives from multiple sources;
 - maintaining a consumer purchase history database based on consumer online shopping activity;
 - receiving a consumer's e-mail address from a consumer's computer;
 - maintaining a consumer database which can identify consumers by their e-mail address;
- and

transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office.

f. Claim 57 Recitations not Alleged by the Examiner

Independent Claim 57 recites:

A Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising:

a purchase history database wherein the data on the consumer purchases are based on online shopping activity;

means for generating a web page with a consumer-specific display;

means for updating said web page; and

means for informing the consumer by e-mail of new incentives.

g. Claim 58 Recitations not Alleged by the Examiner

Independent Claim 58 recites:

A method for delivery of incentives by e-mail, comprising the steps of:

maintaining a consumer database which identifies consumers by their e-mail address;

generating targeted purchase incentives from a consumer purchase history database;

formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon; and

delivering the email message to an email address stored in said consumer database for said consumer.

Therefore, the rejections under 35 USC 103(a) of claims 32-91 are improper and should be reversed.

c. Objectively Implausible Nature of the Examiner's Factual Assertions Regarding his Personal Experience

The panel reviewing this appeal should also measure the probative value of the examiner's factual assertions of his personal knowledge of prior art in the final office action in view of the impugning evidence submitted below.

The examiner made blanket statements in the office action mailed September 17, 2003 at

page 6 line 7 through page 9 line 6 that a large number of limitations defined by claims 32-91 were known to him as having been present in the PerformanceBike.com web site since at least 1994.²

In fact, the examiner also made the same type of blanket statement regarding the PerformanceBike.com web site in rejecting all claims in the related attorney docket CAT/29US-SCROCO, application number 09/401,939, in the office action mailed November 22, 2002 at page 6 line 11 through page 9 line 8.³ This application is now on appeal. In the CAT/29US-SCROCO, application number 09/401,939 office action mailed November 22, 2002 at page 17 line 3 through page 19 line 19, the examiner included an affidavit alleging the existence and functionality of the PerformanceBike.com website.⁴

The examiner also made the same type of blanket statement regarding the PerformanceBike.com web site in rejecting all claims in attorney docket PIP-50-KENN, application number 09/526,535, filed March 16, 2000, in the office action mailed December 18, 2002 at page 4 line 15 through page 7 line 22.⁵ This application is now on appeal. In the office action in PIP-50-KENN mailed December 18, 2002, at page 11 line 3 through page 14 line 9, the examiner included an affidavit specifying the alleged functionality of the PerformanceBike.com website in 1994 in support of his obviousness rejection.⁶

However, in each one of the following applications: CAT/29US-SCROCO application

² Attachment 1 is a copy of pages 6-9 of the office action mailed September 17, 2003 in the subject application.

³ Attachment 2 is a copy of pages 6-9 of the office action mailed November 22, 2002 in application number 09/401,939.

⁴ Attachment 6 is a copy of the 3 page examiner affidavit supporting obviousness rejection contained in the official action mailed November 22, 2002 in application number 09/401,939.

⁵ Attachment 3 is a copy of pages 4-7 of the office action mailed December 18, 2002 in application number 09/526, 535.

⁶ Attachment 4 is a copy of the 4 page examiner affidavit supporting obviousness rejection contained in the official action mailed December 18, 2002 in application number 09/526,535.

number 09/401,939; PIP-50-KENN application number 09/526,535; and the subject application (CAT/29US-SCRCO3, application number 09/756,788), the applicants filed in May and June 2003 probative evidence that the examiner's assertions were false.⁷ In the office action mailed September 17, 2003, in this application, the examiner recanted, stating that:

The examiner experience discussed above teaches the invention **except for the claimed web site or page, online interaction, or e-mail communication.** [Page 8 lines 12-13; emphasis added.]

Therefore, the examiner admitted that his prior factual assertions in support of the rejections of claims 32-58 under 103(a) were false.

i. **The Examiner's Allegations in the Subject Application**

In the subject application, in the office action mailed May 21, 2003, the examiner alleged personal knowledge that in 1994 the PerformanceBike.com website included every limitation in every claim, except for those claims pertaining an e-mail notification. Specifically, at page 6 line 4 through page 7 line 14, the examiner stated that:

Claims 32-91 are rejected under 35 USC 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by **PerformanceBike.com** (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method and system of:

- a **web site** for providing purchasing incentives from multiple sources;
- a consumer purchase history database based on consumer **online** shopping activating [sic];
- a consumer database which can identify consumers by their addresses, wherein said consumer database is connected to said **website** so as to receive consumer data from said **web site**; and any one of
 - means for delivering purchasing incentives or **web site visit** notices to consumers;
 - means for delivering notices to purchase a specific manufacturer's product;

⁷ The probative evidence includes:

Attachment 7: a copy of pages 11-23 of the appeal brief filed in PIP50-KENN-US, application number 09/526,535, filed May 16, 2003.

Attachment 8: a copy of pages 13-22 of the appeal brief filed in CAT29US-SCROCO, application number 09/401,939, filed March 14, 2003.

Attachment 9: a copy of pages 22-29 of the amendment filed in the subject application on April 17, 2003.

transmitting purchase incentives or **web site visit** notices via a post office; and means for or a method informing of new incentives or printing coupons.

Examiner also has personal knowledge of consumer profile basis, purchase history database either by an independently administered or cooperative **site**, and where purchase history includes data based on past purchasing activity. The claimed **web site** for providing purchasing incentives from multiple sources occur when the examiner went into a PerformanceBike retail outlet store, associated **web site** or kiosk and viewed discounted products from a sales catalog. The claimed consumer purchase history database based on consumer **online** shopping activating [sic] occurs when the examiner became a member of Team Performance which is a frequent buyer program and submitted demographic data. The claimed consumer database which can identify consumers by their addresses, wherein said consumer database is connected to said **website** so as to receive consumer data from said web site occurs when examiner submitted data to associate the PerformanceBike retail database to receiving shipping information. The claimed steps including means for delivering purchasing incentives or **web site visit** notices to consumers, means for delivering notices to purchase a specific manufacturer's product, transmitting purchase incentives or **web site visit** notices via a post office, and means for or a method informing of new incentives or printing coupons were administered by PerformanceBike through sale mailings which included coupons of products available either at the retail outlet or **web site**. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. [Office action mailed May 21, 2003 page 6 line 4 through page 7 line 14; emphasis added.]

In the same office action in this application, the examiner also asserted that:

Furthermore, examiner experience teaches the claimed invention except for the claimed e-mail notification. [Office action mailed May 21, 2003 page 7 lines 17-18.]

The May 21, 2003 office action quoted above recants personal knowledge based upon the PerformanceBike.com website, by stating that:

The examiner experience discussed above teaches the invention except for the claimed web site or page, online interaction, or e-mail communication. [Office action mailed September 17, 2003 page 8 lines 12-13.]

This factual assertion, lacking the reliance the examiner had previously placed upon the PerformanceBike.com web site, is clearly an admission that the examiner's prior assertions under oath were false. It was of course the applicants' submission of the highly probative evidence noted above that forced this admission. The examiner's admission that his assertions

under oath were false is reason for the Board to discount any remaining assertions of the examiner's personal knowledge.

**ii. The Examiner's Related Allegations in
Attorney Docket CAT/29US-SCROCO,
Application Number 09/401,939**

In attorney docket CAT/29US-SCROCO, application number 09/401,939, in the office action mailed November 22, 2002, the examiner alleged the existence of the PerformanceBike.com website in 1994 provided him personal knowledge of every limitation in every claim contained in that application. The examiner stated that:

Claims 32-70 are rejected under 35 USC 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:
transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network... [Office action mailed November 22, 2002 page 6 lines 11-16.]

**iii. The Examiner's Related Allegations in
Attorney Docket PIP-50-KENN, Application
Number 09/526,535**

In attorney docket PIP-50-KENN, application number 09/526,535, in the office action mailed December 18, 2002, the examiner alleged the existence of the PerformanceBike.com website in 1994 provided him personal knowledge of every limitation in every claim contained in that application. The examiner stated that:

Claims 1-74 are rejected under 35 USC 103(a) as being unpatentable over an obvious variation of examiner's personal experience of a method or system of targeted research information as provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method or system comprising... [Office action mailed December 18, 2002 page 4 lines 15-18.]

The examiner's allegations that so many limitations in so many claims in the three applications were personally known to him are objectively implausible. For this additional reason, the Board should question the probative value of the examiner's remaining assertions of personal knowledge and accord them little or no probative weight.

d. The Improper Reliance upon Official Notice

The examiner noted that:

It is also considered old and well known that the claimed consumer profile basis, purchase history database either independently administered or of a cooperative form, and where purchase history includes data based on past purchasing activity are part of a system and method of delivering incentives. Official notice is taken of these old and well known claimed steps because . . . [Office action mailed September 17, 2003 page 6 line 18 through page 7 line 4.]

In reply, the applicants first submit that the examiner's reliance on official notice is improper, since it forms the basis for the examiner's obviousness conclusion. See Barry, "Did You Ever Notice? Official Notice in Rejections" 81 JPTOS 129 (1999).⁸ Therefore, the rejections of claims 32-91 relying upon the official notice are improper and should be reversed.

Moreover, the examiner's reasoning for taking official notice is flawed. The examiner reasoned that:

It is also considered old and well known that the claimed consumer profile basis, purchase history database either independently administered or of a cooperative form, and where purchase history includes data based on past purchasing activity are part of a system and method of delivering incentives. Official notice is taken of these old and well known claimed steps because specifically:

a consumer profile basis results in different incentives for a given customer profile (e.g. an incentive delivery to a PerformanceBike consumer who strives to be a Tour de France competitor rather than one who desires a new tricycle for a younger family member is a key element of a consumer profile basis), [Office action mailed September 17, 2003 page 6 line 18 through page 7 line 8.]

In reply, the applicants submit that (1) the statement is incomprehensible and (2) noticing that "a consumer profile basis results in different incentives for a given customer profile" is not an appropriate circumstance for reliance upon official notice. In addressing this topic, MPEP 2144.03(A) states that:

While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge

⁸ Attachment 5 is a copy of Barry, "Did You Ever Notice? Official Notice in Rejections" 81 JPTOS 129 (1999).

in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing In re Knapp Monarch Co., 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

By taking official notice, the examiner asserts that certain facts are well-known or are common knowledge in the art and are capable of instant and unquestionable demonstration. The applicants dispute these assertions because these facts are not capable of instant and unquestionable demonstration as being well-known. Therefore, the rejections of claims 32-91 relying upon the official notice are improper and should be reversed.

Furthermore, the applicants submit that by alleging official notice that “a consumer profile basis . . .” was well known, the examiner has alleged official notice of state of the art technology. In addressing this topic, MPEP 2144.03(A.) cites the court in In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) and stated that:

[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.

Since the examiner is attempting to have you take judicial notice of the state of the art, which the court in In re Eynde states is not amenable to the taking of such notice, the rejections of claims 32-91 relying upon the official notice are improper and should be reversed.

The examiner attempts to justify taking official notice, indicating that he is taking official notice because:

a purchase history database either independently administered or of a cooperative form results marketing mailings and where purchase history includes data based on past purchasing activity (e.g. homeowners are often targeted with offers of home mortgage refinancing, home improvements such as roofing, gutter cleaning, or window replacement based on their past purchase of a home or when a tricycle purchase results in offers of children products such as child helmets, tricycle horns, tricycle bells and the like) [sic]. [Office action mailed September 17, 2003 page 7 lines 9-14.]

In reply, the applicants submit that, because the taking of official notice forms the basis for the examiner’s obviousness conclusion, the notice is not supportable on appeal, and because the examiner is attempting to take official notice of state of the art technology, the notice is

improper, and rejections relying thereupon cannot be sustained. Therefore, the 103 rejections of claims 32-91 should be reversed.

5. **37 CFR 1.192(c)(8)(v) - Other Rejections**

a. **The Rejections Under the Judicially Created Doctrine of Obviousness-Type Double Patenting of Claims 32-91**

1. **The Examiner's Argument**

In support of the rejections of claims 32-91 under the judicially created doctrine of obviousness-type double patenting, the examiner stated that:

Claims 32-58 [sic] are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-39 of U.S. Patent No. 6,014,634 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim transmitting/receiving customer information over a network ('469 patent) is an obvious variation of the application claimed e-mail, because the patented claim personal information transmission data over a network ('634 patent) is an obvious variation of the application claimed e-mail, and because the patented claim of transmitting e-mail purchase incentive because in all three cases, both perform the same function in the same manner with the same result. [Office action mailed September 17, 2003 page 9 lines 8 through 17.]

2. **The Applicants' Response**

a. **The Double Patenting Rejections of Claims 32-91 Over Claims 1-3 of U.S. Patent No. 5,970,469**

In reply, the applicants submit that these rejections should be reversed. The examiner has not made a prima facie case and there is no substantial evidence supporting these rejections.

First, the examiner has not made a limitation by limitation comparison to show why any one of claims 32-91 would have been obvious in view of any one of claims 1-3 in USP 5,970,469. Therefore, the rejections are improper.

Second, the claims in Patent No. 5,970,469 are generally directed to a method and system for distributing purchasing incentives to retail customers including the steps of: transmitting a list of recipes to the customer, receiving customer selection of one or more recipes, transmitting back to the customer a shopping list that includes ingredients needed for each recipe, and transmitting to the customer at least one purchase incentive pertaining to an ingredient product used in a selected recipe.

In contrast, the claims in the pending application are directed to a method and system using a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, and means for delivering purchasing incentives to consumers by e-mail. Therefore, the double patenting rejections of claims 32-91 are improper and should be reversed.

b. The Double Patenting Rejections of Claims 32-91 Over Claims 1-39 of U.S. Patent No. 6,014,634

In reply, the applicants submit that these rejections should be reversed. The examiner has not made a prima facie case and there is no substantial evidence supporting these rejections.

First, the examiner has not made a limitation by limitation comparison to show why claims 32-91 would have been obvious in view of any one of claims 1-39 in USP 5,970,469. Therefore, the rejections are improper.

Second, the claims in 6,014,634 are generally directed to a computer implemented method for determining purchasing incentives for consumers including the steps of generating page data defining a personal web page.

In contrast, the claims in the pending application are directed to a method and system consisting of a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, and means for delivering purchasing incentives to consumers by e-mail. Therefore, the double patenting rejections of claims 32-91 are improper and should be reversed.

c. The Double Patenting Rejections of Claims Over Claims 1-10 of U.S. Patent No. 6,185,541

In reply, the applicants submit that these rejections should be reversed. The examiner has not made a prima facie case and there is no substantial evidence supporting these rejections.

First, the examiner has not made a limitation by limitation comparison to show why claims 32-91 would have been obvious in view of any one of claims 1-10 in USP 5,970,469. Therefore, the rejections are improper.

Second, the claims in Patent No. 6,185,541 are generally directed to a method and system for receiving the user's personal identity and region data and transmitting a selected region purchase incentive offer to the user, wherein the incentive offer contains very detailed image elements.

In contrast, the claims in the pending application are directed to a method and system consisting of a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, and means for delivering purchasing incentives to consumers by e-mail. Therefore, the double patenting rejections of claims 32-91 are improper and should be reversed.

IV. Groupings of Claims - Why Rejections of Each Group Should be Reversed

A. Group 1 - Claims 32, 33, 68, 69, and 73

The rejections of claims 32, 33, 68, 69, and 73 should be reversed because the examiner's personal experience does not suggest "A system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources", "a consumer purchase history database based on consumer online shopping activity", "a consumer database which can identify consumers by their e-mail addresses", "wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site", or "means for delivering purchasing incentives to consumers by e-mail", and these claims comply with 35 USC 112.

B. Group 2 - Claim 34

Since claim 34 depends from independent claim 32, the rejections should be reversed for at least the reasons given above for claim 32.

Moreover, the rejections of claim 34 should be reversed because the examiner's personal experience does not suggest "the consumer purchase history database and said consumer database are integrated", and this claim complies with 35 USC 112.

C. Group 3 - Claim 35

Since claim 35 depends from independent claim 32, the rejections should be reversed for at least the reasons given above for claim 32.

Moreover, the rejections of claim 35 should be reversed because the examiner's personal experience does not suggest "said Web site is an independently administered Web site", and this claim complies with 35 USC 112.

D. Group 4 - Claims 38 and 43

The rejections of claims 38 and 43 should be reversed because the examiner's personal experience does not suggest "A system for delivering incentives over the Internet comprising: a

Web site for providing purchasing incentives from multiple sources”, “a consumer purchase history database based on consumer online shopping activity”, “a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site”, and “a means for delivering by e-mail notices which remind consumers to visit said Web site”, and these claims comply with 35 USC 112.

E. Group 5 - Claim 39

Since claim 39 depends from independent claim 38, the rejections should be reversed for at least the reasons given above for claim 38.

Moreover, the rejections of claim 39 should be reversed because the examiner’s personal experience does not suggest “said means for delivering e-mail notices delivers notices based on consumer profile”, and this claim complies with 35 USC 112.

F. Group 6 - Claim 40

Since claim 40 depends from independent claim 38, the rejections should be reversed for at least the reasons given above for claim 38.

Moreover, the rejections of claim 40 should be reversed because the examiner’s personal experience does not suggest “the consumer purchase history database and said consumer database are integrated”, and this claim complies with 35 USC 112.

G. Group 7 - Claim 41

Since claim 41 depends from independent claim 38, the rejections should be reversed for at least the reasons given above for claim 38.

Moreover, the rejections of claim 41 should be reversed because the examiner’s personal experience does not suggest “said Web site is an independently administered Web site”, and this claim complies with 35 USC 112.

H. Group 8 - Claim 42

Since claim 42 depends from independent claim 38, the rejections should be reversed for at least the reasons given above for claim 38.

Moreover, the rejections of claim 42 should be reversed because the examiner’s personal experience does not suggest “said Web site is a cooperative Web site”, and this claim complies with 35 USC 112.

I. Group 9 - Claims 44 and 49

The rejections of claim 44 and 49 should be reversed because the examiner's personal experience does not suggest "A system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources", "a consumer purchase history database based on consumer online shopping activity", "a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site", and "means for delivering by e-mail notices to purchase a specific manufacturer's product", and these claims comply with 35 USC 112.

J. Group 10 - Claim 45

Since claim 45 depends from independent claim 44, the rejections should be reversed for at least the reasons given above for claim 44.

Moreover, the rejections of claim 45 should be reversed because the examiner's personal experience does not suggest "said means for delivering e-mail notices delivers notices based on consumer profile", and this claim complies with 35 USC 112.

K. Group 11 - Claim 46

Since claim 46 depends from independent claim 44, the rejections should be reversed for at least the reasons given above for claim 44.

Moreover, the rejections of claim 46 should be reversed because the examiner's personal experience does not suggest "the consumer purchase history database and the consumer database are integrated", and this claim complies with 35 USC 112.

L. Group 12 - Claim 47

Since claim 47 depends from independent claim 44, the rejections should be reversed for at least the reasons given above for claim 44.

Moreover, the rejections of claim 47 should be reversed because the examiner's personal experience does not suggest "said Web site is and independently administered Web site", and this claim complies with 35 USC 112.

M. Group 13 - Claim 48

Since claim 48 depends from independent claim 44, the rejections should be reversed for at least the reasons given above for claim 44.

Moreover, the rejections of claim 48 should be reversed because the examiner's personal experience does not suggest "said Web site is a cooperative Web site", and this claim complies with 35 USC 112.

N. Group 14 - Claims 50, 79, 80, 84, 85, and 89

The rejections of claims 50, 79, 80, 84, 85, and 89 should be reversed because the examiner's personal experience does not suggest "A method for delivering purchasing incentives over the Internet comprising the steps of: providing a Web site which offers shopping incentives from multiple sources", "maintaining a consumer purchase history database based on consumer online shopping activity", "receiving a consumer's e-mail address from a consumer's computer", "maintaining a consumer email database which can identify consumers by their e-mail address", and "transmitting purchase incentives via an e-mail post office", and these claims comply with 35 USC 112.

O. Group 15 - Claim 51

Since claim 51 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claim 50.

Moreover, the rejections of claim 51 should be reversed because the examiner's personal experience does not suggest "the step of transmitting purchase incentives to the consumer by electronic mail includes transmitting purchase incentives based on a consumer profile", and this claim complies with 35 USC 112.

P. Group 16 - Claim 52

Since claim 52 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claim 50.

Moreover, the rejections of claim 52 should be reversed because the examiner's personal experience does not suggest "the step of providing a Web site is performed by an independent Web site administrator", and this claim complies with 35 USC 112.

Q. Group 17 - Claim 53

Since claim 53 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claim 50.

Moreover, the rejections of claim 53 should be reversed because the examiner's personal experience does not suggest "the step of providing a Web site is achieved cooperatively", and

this claim complies with 35 USC 112.

R. Group 18 - Claim 54

The rejections of claim 54 should be reversed because the examiner's personal experience does not suggest "A method for delivering purchasing incentives over the Internet comprising the steps of: providing a Web site which offers shopping incentives from multiple sources", "maintaining a consumer purchase history database based on consumer online shopping activity", "receiving a consumer's e-mail address from a consumer's computer", "maintaining a consumer email database which can identify consumers by their e-mail address", and "transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office", and this claim complies with 35 USC 112.

S. Group 19 - Claim 55

Since claim 55 depends from independent claim 54, the rejections should be reversed for at least the reasons given above for claim 54.

Moreover, the rejections of claim 55 should be reversed because the examiner's personal experience does not suggest "the step of providing a Web site is performed by an independent Web site administrator", and this claim complies with 35 USC 112.

T. Group 20 - Claim 56

Since claim 56 depends from independent claim 54, the rejections should be reversed for at least the reasons given above for claim 54.

Moreover, the rejections of claim 56 should be reversed because the examiner's personal experience does not suggest "the step of providing a Web site is achieved cooperatively", and this claim complies with 35 USC 112.

U. Group 21 - Claim 57

The rejections of claim 57 should be reversed because the examiner's personal experience does not suggest "a purchase history database wherein the data on the consumer purchases are based on online shopping activity", "means for generating a web page with a consumer-specific display", "means for updating said web page", and "means for informing the consumer by e-mail of new incentives", and this claim complies with 35 USC 112.

V. Group 22 - Claim 58

The rejections of claim 58 should be reversed because the examiner's personal

experience does not suggest “A method for delivery of incentives by e-mail, comprising the steps of: maintaining a consumer database which identifies consumers by their e-mail addresses”, “formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon”, and “delivering the email message to an email address stored in said consumer database for said consumer”, and this claim complies with 35 USC 112.

W. Group 23 - Claims 59 and 76

Since claim 59 depends from independent claim 32 and claim 76 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 59 and 76 should be reversed because the examiner’s personal experience does not suggest “said online shopping activity stored in said consumer purchase history database comprises shopping list selections data”, and these claims comply with 35 USC 112.

X. Group 24 - Claims 60 and 77

Since claim 60 depends from independent claim 32 and claim 77 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claim 60 and 77 should be reversed because the examiner’s personal experience does not suggest “said online shopping activity stored in said consumer purchase history database comprises rebate offers data”, and these claims comply with 35 USC 112.

Y. Group 25 - Claims 61 and 78

Since claim 61 depends from independent claim 32 and claim 78 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 61 and 78 should be reversed because the examiner’s personal experience does not suggest “said online shopping activity stored in said consumer purchase history database comprises notices detailing specific offers data”, and these claims comply with 35 USC 112.

Z. Group 26 - Claims 62 and 79

Since claim 62 depends from independent claim 32 and claim 69 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 62 and 79 should be reversed because the examiner's personal experience does not suggest "said online shopping activity stored in said consumer purchase history database comprises focused incentives based on a consumer's prior shopping activity data", and these claims comply with 35 USC 112.

AA. Group 27 - Claims 63 and 80

Since claim 63 depends from independent claim 32 and claim 80 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 63 and 80 should be reversed because the examiner's personal experience does not suggest "said online shopping activity stored in said consumer purchase history database comprises purchasing incentives for data defining coupons for subsequent printing by a consumer", and these claims comply with 35 USC 112.

AB. Group 28 - Claims 64 and 81

Since claim 64 depends from independent claim 32 and claim 81 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 64 and 81 should be reversed because the examiner's personal experience does not suggest "said online shopping activity stored in said consumer purchase history database comprises links to at least one of manufacturer and retailer web sites", and these claims comply with 35 USC 112.

AC. Group 29 - Claims 65 and 82

Since claim 65 depends from independent claim 32 and claim 82 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 65 and 82 should be reversed because the examiner's personal experience does not suggest "said online shopping activity stored in said consumer

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purchase history database comprises data enabling a consumer to request at least one of information regarding a product and a sample of said product”, and these claims comply with 35 USC 112.

AD. Group 30 - Claims 66 and 83

Since claim 66 depends from independent claim 32 and claim 83 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 66 and 83 should be reversed because the examiner’s personal experience does not suggest “said consumer purchase history database stores data from any online shopping activity”, and these claims comply with 35 USC 112.

AE. Group 31 - Claims 67 and 84

Since claim 67 depends from independent claim 32 and claim 84 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 67 and 84 should be reversed because the examiner’s personal experience does not suggest “said consumer purchase history database stores an administrator of said system’s web site data”, and these claims comply with 35 USC 112.

AF. Group 32 - Claims 70 and 86

Since claim 70 depends from independent claim 32 and claim 86 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 70 and 86 should be reversed because the examiner’s personal experience does not suggest “said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household”, and these claims comply with 35 USC 112.

AG. Group 33 - Claims 71 and 87

Since claim 71 depends from independent claim 32 and claim 87 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Moreover, the rejections of claims 71 and 87 should be reversed because the examiner's personal experience does not suggest "code for generating targeted, time phased incentives based on a consumer's actual buying patterns and preferences", and these claims comply with 35 USC 112.

AH. Group 34 - Claims 72 and 88

Since claim 72 depends from independent claim 32 and claim 88 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Therefore, the rejections of claims 72 and 88 should be reversed because the examiner's personal experience does not suggest "code for generating untargeted incentives offered by manufacturers or retailers", and these claims comply with 35 USC 112.

AI. Group 35 - Claims 74 and 90

Since claim 74 depends from independent claim 32 and claim 90 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Therefore, the rejections of claims 74 and 90 should be reversed because the examiner's personal experience does not suggest "said purchase incentives contain data enabling purchase incentives to be printed at point of sale", and these claims comply with 35 USC 112.

AJ. Group 36 - Claims 75 and 91

Since claim 75 depends from independent claim 32 and claim 91 depends from independent claim 50, the rejections should be reversed for at least the reasons given above for claims 32 and 50.

Therefore, the rejections of claims 75 and 91 should be reversed because the examiner's personal experience does not suggest "means to encode in a consumer's identification card, tokens representing said purchase incentives", and these claims comply with 35 USC 112.

AK. Group 37 - Claim 37

Since claim 37 depends from independent claim 32, the rejections should be reversed for at least the reasons given above for claim 32.

Moreover, the rejections of claim 37 should be reversed because the examiner's personal

experience does not suggest “said consumer purchase history database includes data based on past purchasing activity”, and this claim complies with 35 USC 112.

AL. Group 38 - Claim 36

Since claim 36 depends from independent claim 32, the rejections should be reversed for at least the reasons given above for claim 32.

Moreover, the rejections of claim 36 should be reversed because the examiner’s personal experience does not suggest “wherein said Web site is a cooperative site”, and this claim complies with 35 USC 112.

V. 37 CFR 1.192(d) - Non-compliant Brief

This brief is in compliance with 37 CFR 1.192(c). Accordingly, this subsection is inapplicable.

VI. List of Attachments

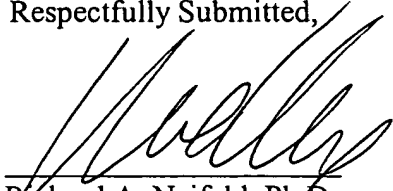
Attachment Number	Description of Attachment
1	Attachment 1 is a copy of pages 6-9 of the office action mailed September 17, 2003 in the subject application.
2	Attachment 2 is a copy of pages 6-9 of the office action mailed November 22, 2002 in application number 09/401,939.
3	Attachment 3 is a copy of pages 4-7 of the office action mailed December 18, 2002 in application number 09/526, 535.
4	Attachment 4 is a copy of the 4 page examiner affidavit supporting obviousness rejection contained in the official action mailed December 18, 2002 in application number 09/526,535.
5	Attachment 5 is a copy of Barry, "Did You Ever Notice? Official Notice in Rejections" 81 JPTOS 129 (1999).
6	Attachment 6 is a copy of the 3 page examiner affidavit supporting obviousness rejection contained in the official action mailed November 22, 2002 in application number 09/401,939.
7	Attachment 7 is a copy of pages 11-23 of the appeal brief filed in PIP50-KENN-US, application number 09/526,535, filed May 16, 2003.
8	Attachment 8 is a copy of pages 13-22 of the appeal brief filed in CAT29US-SCROCO, application number 09/401,939, filed March 14, 2003.
9	Attachment 9 is a copy of pages 22-29 of the amendment filed in the subject application on April 17, 2003.
10	Attachment 10 is a copy of page 4 of the office action mailed May 14, 2002 in reexamination number 90/005,888.

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PATENT TRADEMARK OFFICE

3/12/04
Date

Respectfully Submitted,


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VII. Appendix - Claims 32-91 Involved in the Appeal

32. A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

means for delivering purchasing incentives to consumers by e-mail.

33. The system of claim 32 wherein said means for delivering purchase incentives delivers purchasing incentives based on consumer profile.

34. The system of claim 32 wherein the consumer purchase history database and said consumer database are integrated.

35. The system of claim 32 wherein said Web site is an independently administered Web site.

36. The system of claim 32 wherein said Web site is a cooperative site.

37. The system of claim 32 wherein said consumer purchase history database includes data based on past purchasing activity.

38. A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

a means for delivering by e-mail notices which remind consumers to visit said Web site.

39. The system of claim 38 wherein said means for delivering e-mail notices delivers notices based on consumer profile.

40. The system of claim 38 wherein the consumer purchase history database and said consumer database are integrated.

41. The system of claim 38 wherein said Web site is an independently administered Web site.

42. The system of claim 38 wherein said Web site is a cooperative Web site.
43. The system of claim 38 wherein said consumer purchase history includes data based on past purchasing activity.
44. A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and
means for delivering by e-mail notices to purchase a specific manufacturer's product.
45. The system of claim 44 wherein said means for delivering e-mail notices delivers notices based on consumer profile.
46. The system of claim 44 wherein the consumer purchase history database and the consumer database are integrated.
47. The system of claim 44 wherein said Web site is and independently administered Web site.
48. The system of claim 44 wherein said Web site is a cooperative Web site.
49. The system of claim 44 wherein said consumer purchase history database includes data based on past purchasing activity.
50. (Amended) A method for delivering purchasing incentives over the Internet comprising the steps of:
providing a Web site which offers shopping incentives from multiple sources;
maintaining a consumer purchase history database based on consumer online shopping activity;
receiving a consumer's e-mail address from a consumer's computer;
maintaining a consumer email database which can identify consumers by their e-mail address; and
transmitting purchase incentives via an e-mail post office.

51. The method of claim 50 wherein the step of transmitting purchase incentives to the consumer by electronic mail includes transmitting purchase incentives based on a consumer profile.

52. The method of claim 50 wherein the step of providing a Web site is performed by an independent Web site administrator.

53. The method of claim 50 wherein the step of providing a Web site is achieved cooperatively.

54. A method for delivering incentives over the Internet comprising the steps of:
providing a Web site which offers purchasing incentives from multiple sources;
maintaining a consumer purchase history database based on consumer online shopping activity;
receiving a consumer's e-mail address from a consumer's computer;
maintaining a consumer database which can identify consumers by their e-mail address;
and
transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office.

55. The method of claim 54 wherein the step of providing a Web site is performed by an independent Web site administrator.

56. The method of claim 54 wherein the step of providing a Web site is achieved cooperatively.

57. A Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising:

a personal database;
a purchase history database wherein the data on the consumer purchases are based on online shopping activity;

means for generating a web page with a consumer-specific display;

means for updating said web page; and

means for informing the consumer by e-mail of new incentives.

58. (Amended) A method for delivery of incentives by e-mail, comprising the steps of:
maintaining a consumer database which identifies consumers by their e-mail addresses;

generating targeted purchase incentives from a consumer purchase history database; and
formatting an e-mail message to a consumer by electronic mail for subsequent printing of
a coupon; and

delivering the email message to an email address stored in said consumer database for said
consumer.

59. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises shopping list selections data.

60. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises rebate offers data.

61. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises notices detailing specific offers data.

62. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises focused incentives based on a consumer's prior
shopping activity data.

63. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises purchasing incentives for data defining coupons
for subsequent printing by a consumer.

64. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises links to at least one of manufacturer and retailer
web sites.

65. (New) The system of claim 32 wherein said online shopping activity stored in said
consumer purchase history database comprises data enabling a consumer to request at least one
of information regarding a product and a sample of said product.

66. (New) The system of claim 32 wherein said consumer purchase history database
stores data from any online shopping activity.

67. (New) The system of claim 32 wherein said consumer purchase history database
stores an administrator of said system's web site data.

68. (New) The system of claim 32 wherein said consumer purchase history database
stores retail store purchase data, including a consumer's favorite brands data.

69. (New) The system of claim 32 wherein said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address.

70. (New) The system of claim 32 wherein said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

71. (New) The system of claim 32 further comprising code for generating targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

72. (New) The system of claim 32 further comprising code for generating untargeted incentives offered by manufacturers or retailers.

73. (New) The system of claim 32 wherein said purchase incentives contain data enabling coupons to be printed by said consumer.

74. (New) The system of claim 32 wherein said purchase incentives contain data enabling purchase incentives to be printed at point of sale.

75. (New) The system of claim 32 further comprising means to encode in a consumer's identification card, tokens representing said purchase incentives.

76. (New) The method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises shopping list selections associated with a particular consumer.

77. (New) The method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises rebate offers data associated with a particular consumer.

78. (New) The method of claim 50 wherein said online shopping activity stored in said consumer purchase history database in association with an identification for a particular consumer comprises data detailing notice of specific offers provided to said particular consumer.

79. (New) The method of claim 50 further comprising generating focused incentives for a consumer based on said consumer's prior shopping activity.

80. (New) The method of claim 50 further comprising generating purchasing incentives data in a form suitable for printing of a coupon by a consumer.

81. (New) The method of claim 50 further comprising generating links to at least one of manufacturer and retailer web sites and associating said links with a particular consumer.

82. (New) The method of claim 50 further comprising enabling a consumer to request at least one of information regarding a product and a sample of a product.

83. (New) The method of claim 50 wherein said consumer purchase history database stores data from an administrator of said system's web site.

84. (New) The method of claim 50 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands.

85. (New) The method of claim 50 wherein said consumer purchase history database stores at least three of said customer identification number, name, residential address, zip code, and email address.

86. (New) The method of claim 50 wherein said consumer purchase history database stores selected consumer demographic information, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

87. (New) The method of claim 50 wherein said purchase incentives include targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

88. (New) The method of claim 50 wherein said purchase incentives include untargeted incentives from at least one of manufacturers and retailers.

89. (New) The method of claim 50 further comprising printing said purchase incentives on a printer connected to and controlled by a consumer's computer.

90. (New) The method of claim 50 further comprising printing purchase incentives at point of sale.

91. (New) The method of claim 50 further comprising encoding in a consumer's identification card tokens representing said purchase incentives.

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targeting incentives are statements of intended use and are also anticipated by Jovicic.

Furthermore, the dependently claimed features, including the amended matter in the newly added thirty-one claims are also considered statements of intended use also anticipated by Jovicic.

Claim Rejections - 35 USC § 103

4. Claims 32-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of consumer purchasing incentive distribution provided by PerformanceBike. Since at least 1994, PerformanceBike has performed the claimed method and system of

providing purchasing incentives from multiple sources;

a consumer purchase history database based on consumer shopping activity;

a consumer database which can identify consumers by their addresses, wherein said consumer database can receive consumer data; and any one of

means for delivering purchasing incentives to consumers,

means for delivering notices to purchase a specific manufacturer's product,

transmitting purchase incentives via post office, and

means for or a method informing of new incentives or printing coupons. It is also considered old and well known that the claimed consumer profile basis, purchase history database either independently administered or of a cooperative form, and where purchase history includes data based on past purchasing activity are part of a system and method of delivering

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incentives. Official notice is taken of these old and well known claimed steps because specifically:

a consumer profile basis results in different incentives for a given consumer profile (e.g. an incentive delivery to a PerformanceBike consumer who strives to be a Tour de France competitor rather than one who desires a new tricycle for a younger family member is a key element of a consumer profile basis),

a purchase history database either independently administered or of a cooperative form results marketing mailings and where purchase history includes data based on past purchasing activity (e.g. homeowners are often targeted with offers of home mortgage refinancing, home improvements such as roofing, gutter cleaning, or window replacement based on their past purchase of a home or when a tricycle purchase results in offers of children products such as child helmets, tricycle horns, tricycle bells and the like).

The claimed providing purchasing incentives from multiple sources occur when the examiner went into a PerformanceBike retail outlet store and viewed incentive discounted products from a sales catalog source or another source such as a seasonal promotional pamphlet separate from the sales catalog. The claimed consumer purchase history database based on consumer shopping activity occurs when the examiner became a member of Team Performance which is a frequent buyer program and submitted demographic data. The claimed consumer database which can identify consumers by their addresses, wherein said consumer database is connected so as to receive consumer data is considered equivalent to the examiner submitting

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data as a Team Performance member to PerformanceBike in order to provide shipping information such that the examiner Team Performance members is identified by the member address which is connected to a PerformanceBike database such that PerformanceBike mails Team Performance members seasonal sales information on a periodic basis. The independently claimed steps including means for delivering purchasing incentives to consumers, means for delivering notices to purchase a specific manufacturer's product, transmitting purchase incentives via post office, and means for or a method informing of new incentives or printing coupons were administered by PerformanceBike through consumer purchasing incentives sale mailings which included manufacturer product coupons of products available either at the retail outlet to examiner postal mailing address. The examiner experience discussed above teaches the invention except for the claimed web site or page, online interaction, or e-mail communication.

- It would have been obvious to one skilled in the art to provide the claimed web site or page, online interaction, or e-mail communication since web site or page, online interaction, or e-mail communication are merely automated features of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art). It is considered that the claimed web site or page, online interaction, or e-mail communication are broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result as discussed under examiner experience as a Team

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Performance member. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities through electronic mail mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention.

Double Patenting

5. Claims 32-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-39 of U.S. Patent No. 6,014,634 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim transmitting/receiving customer information over a network ('469 patent) is an obvious variation of the application claimed e-mail, because the patented claim personal information transmission data over a network ('634 patent) is an obvious variation of the application claimed e-mail, and because the patented claim of transmitting e-mail purchase incentive because in all three cases, both perform the same function in the same manner with the same result.

Response to Amendments & Arguments

6. Applicant's arguments filed April 17, 2003 have been fully considered but they are not persuasive.

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also rejected as being indefinite from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter.

Claim Rejections - 35 USC § 102

7. Claims 32-70 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863), Deaton et al. (US 5,430,644), or Day et al. (US 5,857,175).

Claim Rejections - 35 USC § 103

8. Claims 32-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

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transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items. Examiner also has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs

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when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased. The dependently claimed steps including instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification are also services and features available using PerformanceBike based on examiner's experience. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious to one skilled in the art to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ

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193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art). The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities, while transferring information, which clearly shows the obviousness of the claimed invention.

Double Patenting

9. Claims 32-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim of encoded data ('469 patent) is an obvious variation of the application claimed token data and the patent claimed advisory message ('541 patent) is an obvious variation of the application claimed general purchase incentive because both perform the same function in the same manner with the same result.

10. Claims 32-70 are rejected under 35 U.S.C. 103(a) as being obvious over copending Application Nos. 09/478,351 or 09/567,274 or 09/716,404. Each application contains claims reciting obvious variation to the claimed method, system, and program of:

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light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 U.S.C. § 102

5. Claims 1-74 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by non-patent literature references "Marketers' Newest Secret Weapon" by Regina Eisman or "On Target at Last" by Michael Garry, Day et al. (US 2001/0013011), or foreign reference Meyer et al. (WO 99/46708) and are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Deaton et al. (US 5,388,165, US 5,430,644, US 5,592,560 or US 5,649,114), Shear et al. (WO 98/10381), O'Brien et al. (US 5,832,457), Jones et al. (US 5,832,458), or Day et al. (US 5,857,175), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Walker et al. (US 5,945,653), Mori et al. (US 6,070,148), Katz et al. (US 6,055,513), or Kepecs et al. (US 6,330,543).

Claim Rejections - 35 U.S.C. § 103

6. Claims 1-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of a method or system of targeted research information as provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method or system comprising:

receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location;

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determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research invitation including contact information to be used by the customer to participate in marketing research; and delivering the targeted research invitation to the customer including a memory device and processor configured to perform the method steps thereof. Examiner also has personal knowledge of the claimed prior purchase history basis received at a host computer, storing and matching customer and point of sale information, participation incentives, unique code numbers, printed research invitations at the point of sale, scanning customer identification information, customer contact information, purchase triggers including comparison, product information receipt, and multiple points of sale including credit/debit/social security card, driver's license, or checking account scanning. The claimed receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location occurs when the examiner presented a Team Performance loyalty customer identification card at a point of sale PerformanceBike retail location that provided a basis for examiner's purchase information and history. The claimed determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research invitation including contact information to be used by the customer to participate in marketing research occurs when the examiner was presented with periodic PerformanceBike sale items based on prior purchases such that examiner was targeted with bicycling products most relevant to examiner's prior purchases, the Team Performance card

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included examiner's customer identifier. Examiner uses a broad reasonable interpretation of "targeted research invitation" to be the same as PerformanceBike offers of tricycles, training wheels, children's safety equipment including helmets, knee and elbow pads, and bicycle flags based on examiner's prior purchase of a bicycling trailer for towing children on a bicycle.

(Another interpretation will be considered for obviating the claimed invention *infra*). The claimed delivering the targeted research invitation to the customer including a memory device and processor configured to perform the method steps thereof occurs when the examiner was mailed (electronically or postally) offers of children's cycling equipment at discount or reduced pricing. PerformanceBike used a computer for the claimed prior purchase history basis received at a host computer, storing and matching customer and point of sale information, participation incentives, unique code numbers, printed research invitations at the point of sale, scanning customer identification information, customer contact information, purchase triggers including comparison, product information receipt, and multiple points of sale including credit/debit/social security card, driver's license, or checking account scanning. Examiner notes that it is old and well known to those skilled in the art of targeted research invitation, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner's personal experience discussed *supra*. Furthermore examiner experience teaches the claimed invention except for the claimed targeted research invitation (as another interpretation). Examiner

considers the claimed targeted research invitation to be merely an obvious variation of the marketing technique used by PerformanceBike to target customers with specific products or

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services. Although examiner has never heard this marketing technique to be recited as "targeted research invitation" it is not patentably distinct using broadest reasonable interpretations under the *Graham* decision. It would have been obvious to one skilled in the art to provide targeted research invitation since that marketing technique is merely an automated features of a concept that is old and well known. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The targeted research invitation is merely an automatic or mechanical means to replace an manual activity based on examiner's personal experience with the claimed method or system comprising: receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location; determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research invitation including contact information to be used by the customer to participate in marketing research; and delivering the targeted research invitation to the customer including a memory device and processor configured to perform the method steps thereof. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers, manufacturers, retailers, and consumer advocacy groups greater consumer targeting capabilities for increased sales and to deliver consumer products that are more likely to be well received by the public, which clearly shows the obviousness of the claimed invention.

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EXAMINER AFFIDAVIT SUPPORTING OBVIOUSNESS REJECTION

Claims 1-74 are an obvious variation over examiner's personal knowledge of a method or system of targeted research information as provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method or system comprising:

receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location;

determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research invitation including contact information to be used by the customer to participate in marketing research; and

delivering the targeted research invitation to the customer including a memory device and processor configured to perform the method steps thereof. Examiner also has personal knowledge of the claimed prior purchase history basis received at a host computer, storing and matching customer and point of sale information, participation incentives, unique code numbers, printed research invitations at the point of sale, scanning customer identification information, customer contact information, purchase triggers including comparison, product information receipt, and multiple points of sale including credit/debit/social security card, driver's license, or checking account scanning. The claimed receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location occurs when the examiner presented a Team Performance loyalty customer identification

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card at a point of sale PerformanceBike retail location that provided a basis for examiner's purchase information and history. The claimed determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research invitation including contact information to be used by the customer to participate in marketing research occurs when the examiner was presented with periodic PerformanceBike sale items based on prior purchases such that examiner was targeted with bicycling products most relevant to examiner's prior purchases, the Team Performance card included examiner's customer identifier. Examiner uses a broad reasonable interpretation of "targeted research invitation" to be the same as PerformanceBike offers of tricycles, training wheels, children's safety equipment including helmets, knee and elbow pads, and bicycle flags based on examiner's prior purchase of a bicycling trailer for towing children on a bicycle. (Another interpretation will be considered for obviating the claimed invention *infra*). The claimed delivering the targeted research invitation to the customer including a memory device and processor configured to perform the method steps thereof occurs when the examiner was mailed (electronically or postally) offers of children's cycling equipment at discount or reduced pricing. PerformanceBike used a computer for the claimed prior purchase history basis received at a host computer, storing and matching customer and point of sale information, participation incentives, unique code numbers, printed research invitations at the point of sale, scanning customer identification information, customer contact information, purchase triggers including comparison, product information receipt, and multiple points of sale including credit/debit/social security card,

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driver's license, or checking account scanning. Examiner notes that it is old and well known to those skilled in the art of targeted research invitation, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner's personal experience discussed supra. Furthermore examiner experience teaches the claimed invention except for the claimed targeted research invitation (as another interpretation). Examiner considers the claimed targeted research invitation to be merely an obvious variation of the marketing technique used by PerformanceBike to target customers with specific products or services. Although examiner has never heard this marketing technique to be recited as "targeted research invitation" it is not patentably distinct using broadest reasonable interpretations under the *Graham* decision. The targeted research invitation is merely an automatic or mechanical means to replace an manual activity based on examiner's personal experience with the claimed method or system comprising: receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location; determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research invitation including contact information to be used by the customer to participate in marketing research; and delivering the targeted research invitation to the customer including a memory device and processor configured to perform the method steps thereof. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers, manufacturers, retailers, and consumer advocacy groups greater consumer targeting capabilities for increased sales and to

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deliver consumer products that are more likely to be well received by the public, which clearly shows the obviousness of the claimed invention.

I hereby declare that all statements made under this declaration of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 U.S.C. 1001 and that such will false statements may jeopardize the validity of the application or any patent issued thereon.

Steve Gavini

tion filing in order to eliminate text that is not essential to obtaining a Japanese patent. Claims that will not provide value to the applicant can be cancelled at any time during the life of the Japanese patent to reduce Examination, issue and/or Annuity fees. In addition, the applicant should give its Japanese patent attorney an opportunity to review and revise the specification before PCT or Paris Convention filings, at least for particularly important inventions, as such review and revision may both reduce the total cost of obtaining the Japanese patent and increase the breadth and strengthen the validity of the claims that ultimately are allowed.

Did You Ever Notice? Official Notice in Rejections*

Lance Leonard Barry**

Jerry Seinfeld, a popular stand-up comedian and television actor, is known for beginning his comedy routines with the question, "Did you ever notice...?"¹ Many Patent Examiners (Examiners) at the United States Patent and Trademark Office (PTO) could answer the question positively. This is because many of them "notice," i.e., take official notice of, well-known facts when composing rejections of claims.

Under the doctrine of official notice, an Examiner need not produce a printed document to prove the existence of a fact that was well known at the time of an invention.² He may instead take official notice as to its existence.³ Taking official notice bypasses the normal process of proof. It relies on facts and opinions not supported by evidence on

* © 1999, All Rights Reserved, Lance Leonard Barry, Esq. The opinions expressed herein are solely the author's and do not necessarily represent the opinions of the United States Patent and Trademark Office (PTO). The author thanks William Watkins, Esq., a Primary Examiner at the PTO, and Robert A. Weinhardt, an Examiner-Trainer at the PTO who also developed courses for the PTO's Patent Academy (Academy), for reviewing a draft of this note.

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1 See Dave Katzman, *Did You Ever Notice how People Will Read Anything*, 81 Daily Egyptian Online 107 (Mar. 5, 1996) (<http://www.dailyegyptian.com/springs96/030596/people/read.html>).

2 PTO, *MANUAL OF PATENT EXAMINING PROCEDURE* (M.P.E.P.) § 2144.03 (7th ed., July 1998). The M.P.E.P. has been held to describe "procedures on which the public can rely." *Paltex Corp. v. Mossinghoff*, 758 F.2d 594, 606, 225 USPQ 243, 252, modified, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); *In re Kaghan*, 387 F.2d 398, 401, 56 USPQ 130, 132 (CCPA 1967); *Eubicon v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988); *Paperless Accounting v. Bay Area Rapid Transit System*, 804 F.2d 659, 662, 231 USPQ 649, 651 (Fed. Cir. 1986).

3 See *Ex parte Crissy*, 201 USPQ 689, 695 (Bd. Pat. App. & Int. 1976) ("[F]acts... must support the legal conclusion of obviousness under 35 USC 103. Such facts must flow from the prior art either by way of specific reference or by generally known facts of which official notice may be taken." (emphasis added)).

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the record.⁴ As such, it is imperative that Examiners and patent attorneys and agents understand the guidance given on the use of official notice to reject claims.

This note aims to increase their understanding in three parts. Part I explains the rationale for official notice. Part II addresses its scope. Part III outlines the use of notice.

I. RATIONALE FOR OFFICIAL NOTICE

As mentioned above, an Examiner need not produce a reference⁵ to prove the existence of a fact well known at the time of an invention.⁶ He may take official notice of its existence.⁷ Administrative efficiency and administrative expertise are two rationales for the doctrine of official notice. These will be explained *separatim*.

Administrative efficiency is one rationale for official notice. Like its courtroom counterpart judicial notice,⁸ official notice derives from the legal maxim *manifesta* [or *notoria*] *non indigent probatione*, i.e., "what is known need not be proved." The maxim may be traced so far back in civil and canon law that it is probably coeval with legal procedure itself.⁹ Back in 1875, for example, the United States Supreme Court observed that to require proof of every fact "would be utterly and absolutely absurd."¹⁰ Where a fact is known, the process of proving it is "time-consuming and unduly formal."¹¹ When a fact has been proven already, further proof becomes "tiresome, redundant, and lacking in common sense."¹² At times, moreover, even an obvious fact can be difficult or time-consuming to prove, without affecting a result that was never in doubt.¹³

⁴ 2 KENNETH S. BROWN ET AL., MCCORMICK ON EVIDENCE § 359, at 536 (John W. Strong ed., 4th ed. 1992).

⁵ A reference is a patent or other printed document used in the rejection of claim. M.P.E.P. § 904.

⁶ *Id.* at § 2144.03.

⁷ See Crissy, 201 USPQ at 695.

⁸ That matters of common knowledge may be judicially noticed is a doctrine long and well established. *In re Malcolm*, 129 F.2d 529, 553, 54 USPQ 235, 238 (CCPA 1942).

⁹ JAMES BRADLEY THAYER, A PRELIMINARY TREATISE ON EVIDENCE AT COMMON LAW 277 (Boston, Little Brown & Co. 1898).

¹⁰ *Brown v. Piper*, 91 U.S. 37, 42 (1875).

¹¹ BROWN, *supra* note 2, § 359, at 537-38.

¹² *Id.* at 538.

¹³ *Id.*

An Examiner is allotted a limited time to dispose of a patent application¹⁴ and is also directed to bring prosecution of the application to as speedy a conclusion as possible.¹⁵ Official notice empowers the Examiner to use time efficiently to make a speedy and just determination of issues in the application.¹⁶ More specifically, it frees the Examiner from having to spend unnecessary time finding a reference to prove the existence of a fact well known at the time of an invention.¹⁷

Administrative expertise is another rationale for official notice. Administrative agencies were created to allow regulation of matters by persons knowledgeable in the matters.¹⁸ They were also created to serve as repositories of specialized knowledge and experience.¹⁹ It would "defeat [the] existence" of these agencies to force adherence to traditional methods of proof when alternative and equally fair methods are available.²⁰

As an administrative agency, the PTO possesses technical knowledge and expertise in determining the patentability of inventions.²¹ It is a knowledge and expertise that Justice (then Circuit Judge) Stevens admitted generally is not possessed by federal judges.²² In particular, the Examiners of the PTO are highly trained scientists and engineers²³ of the highest-caliber.²⁴ They possess an independent and specialized

¹⁴ Cf. Michael J. Metham, *Strategic Concerns when Pursuing Foreign Patents in The Computer Age*, THE COMPUTER LAWYER, Mar. 1998, at 17, 25 (noting that the European Patent Office's examiners are "allowed more time to examine each application" than the PTO's Examiners); DAVID PRESSMAN, PATENT IT YOURSELF 13/6 (5th ed. 1996) (noting that Examiners are expected to dispose of a certain number of patent applications).

¹⁵ M.P.E.P. § 706.07. See also PTO, A PATENT AND TRADEMARK OFFICE REVIEW 8-9 (Fiscal Year 1997) (setting a first strategic goal of reducing "patent cycle time").

¹⁶ M.P.E.P. § 904.02.

¹⁷ *Id.* at § 2144.03 ("[T]he examiner should not be obliged to spend time to produce documentary proof.")

¹⁸ 4 BASIL J. MEZINES ET AL., ADMINISTRATIVE LAW § 25.01 (1980).

¹⁹ BROWN, *supra* note 2, § 359, at 538.

²⁰ *Id.*

²¹ Plastic Container Corp. v. Continental Plastics of Okla., Inc., 708 F.2d 1554, 1557, 219 USPQ 26, 28 (10th Cir. 1983).

²² Chicago Rawhide Mfg. Co. v. Crane Packing Co., 523 F.2d 452, 458, 187 USPQ 540, 545 (7th Cir. 1975). See also Nat'l Bus. Systems, Inc. v. AM Int'l, Inc., 743 F.2d 1227, 1232, 223 USPQ 1011, 1014 (7th Cir. 1984) ("The courts generally defer to the technical expertise possessed by the [PTO] in originally issuing a patent. This expertise and corresponding judicial deference are the practical underpinnings of the statutory presumption of validity surrounding patents."); Aqua-Chem, Inc. v. Baldwin-Lima-Hamilton Corp., 67 USPQ 257, 261 (N.D. Ill. 1970) ("The [PTO] has developed a certain amount of technical expertise which most judges lack.")

²³ PTO, *Patent Examiner Positions*, ¶ 1 (last modified July 1, 1998) (<http://www.uspto.gov/web/offices/ac/ahrpa/ohr/employment/exam.htm#org>).

²⁴ See PTO, *supra* note 15, at 8.

technical expertise.²⁵ Such expertise is seldom possessed by a reviewing court.²⁶ Official notice permits the Examiners to use fully their expertise in adjudicating the patentability of discoveries of inventors throughout the world.²⁷

II. SCOPE OF OFFICIAL NOTICE

Official notice typically is employed to supplement or clarify a reference, i.e., to justify or explain an inference drawn from it. A fact so noticed serves to fill gaps that might exist in other evidence cited to support a rejection.²⁸ A noticed fact usually is not employed as the principal evidence for a rejection.²⁹

Like judicial notice, official notice may be taken of a fact of "wide notoriety,"³⁰ e.g., a fact commonly known by laymen everywhere.³¹ *In re Howard*³² provides a prototypical example of a widely notorious fact. *Howard* involved the patentability of claims specifying a method of pricing merchandise. The method reduced the amount of manual handling of merchandise stocked and displayed in a retail grocery store.³³

²⁵ *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970). See also *Semiconductor Energy Laboratory Co. v. Samsung Elec. Co.*, 46 USPQ2d 1874, 1877 n.6 (E.D. Va. 1998) ("[E]xaminers are skilled in the art insofar as they are technically competent to understand information and references in some technical or scientific field. . ."); *Creative Indus. Inc. v. Mobil Chem. Corp.*, 13 USPQ2d 1534, 1537 (N.D. Ill. 1989) ("The patent examiner, of course, possessed the technical expertise necessary to understand the prior art as well as the subject matter of patent applications within his area of responsibility."); *Rixon, Inc. v. Racal-Milgo, Inc.*, 551 F.Supp. 163, 174, 217 USPQ 941, 950 (D. Del. 1982) ("The patent examiner had the . . . reference and technical expertise to evaluate it.").

²⁶ *In re Wiechert*, 370 F.2d 927, 952, 152 USPQ 247, 266 (CCPA 1967) (Smith, J., dissenting).
²⁷ PTO, *supra* note 23, ¶ 1.

²⁸ *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970). *Ahlert* uses the expression "judicial notice" rather than official notice. Technically speaking, judicial notice is for a court while official notice is for an administrative agency. Robert Muir, *The Utilization of Both Judicial Notice and Official Notice by Administrative Agencies*, 16 AD. L. REV. 333, 334 (1964). It is common—albeit obfuscating—to refer to the taking of official notice by an Examiner as judicial notice. See, e.g., PETER D. ROSENBERG, *PATENT LAW FUNDAMENTALS* § 15.06[2] (2d ed. 1995) ("Official notice taken of matters beyond the record is referred to as 'judicial notice.'"); *Irah H. Donner, Combating Obviousness Rejections Under 35 U.S.C. Section 103*, 6 ALB. L.J. Sci. & Tech. 159, 195 (1996) ("if an Examiner does not specifically cite prior art references but uses judicial notice").

²⁹ *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421. But see *In re Howard*, 394 F.2d 869, 157 USPQ 615 (CCPA 1968) (using judicial notice, in the words of a concurring opinion, "to find that a system exists which anticipates that of the application or is so nearly like it as to make the application an obvious variation").

³⁰ *In re Howard*, 394 F.2d 869, 870, 157 USPQ 615, 616 (CCPA 1968).

³¹ *Cf.* 29 AM. JUR. 2d *Evidence* § 33 (1994) ("A fact might qualify for judicial notice because it is common knowledge everywhere. The basic appearance of a snowman, for example, is common knowledge.")

³² 394 F.2d 869, 157 USPQ 615.

³³ *Id.* at 869–70, 157 USPQ at 615–16.

In affirming a rejection of the claims, the United States Court of Customs and Patent Appeals (CCPA)³⁴ took notice of the retailing practice of listing goods for sale by code along with the price of each. This practice helped a sales clerk to learn the amount to charge a customer purchasing the goods.³⁵ The CCPA observed that the practice related back to the "proverbial country merchant" who has his present-day counterpart in the supermarket cashier who tapes a price list of advertised "specials" to his cash register.³⁶ The court also noted the deluge of mail order catalogs that list merchandise by code along with its price, which "common observation cannot escape," as further evidence of the wide notoriety of the retailing practice.³⁷

*In re Fox*³⁸ offers another example of a widely notorious fact. *Fox* involved the patentability of claims specifying a method for distributing audio information. The method employed conventional equipment to make a master tape-recording of a lecture. The master recording was transmitted to a distribution point such as a school library. At the library copies of the master were made for persons wishing to listen to the lecture on their own equipment at their own convenience. When finished listening to a taped copy, a person could return the copy to have a new lecture reproduced thereon from another master tape-recording at the library. This new reproduction would, of course, entail erasing the recording already on the tape.³⁹

In affirming a rejection of the claims, the PTO's Board of Appeals (Board)⁴⁰ took official notice and the CCPA took judicial notice of "the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it."⁴¹ This fact is notorious. Consumers recording over a prerecorded video tape or audio tape-recording take it for granted that the original recording will be erased during the new recording.⁴²

³⁴ The CCPA was the predecessor of the United States Court of Appeals for the Federal Circuit (Federal Circuit) in reviewing patentability appeals from the PTO. *Lance Leonard Barry, Precedent for Ex Parte Patent Prosecution*, 78 J. PAT. & TRADEMARK OFF. SOC'Y 841, 844–45 (1996).

³⁵ *Howard*, 394 F.2d at 870, 157 USPQ at 616.

³⁶ *Id.* at 870–71, 157 USPQ at 616.

³⁷ *Id.* 157 USPQ at 616.

³⁸ 471 F.2d 1405, 176 USPQ 340 (CCPA 1973).

³⁹ *Id.* at 1405, 176 USPQ at 340.

⁴⁰ The Board of Appeals was the forerunner of the Board of Patent Appeals and Interferences in reviewing patentability appeals from the decision of a Primary Examiner within the PTO. *Barry, supra* note 34, at 853.

⁴¹ 471 F.2d at 1407, 176 USPQ at 341.

⁴² Like the CCPA, the Federal Circuit also has taken notice of widely notorious facts in its review of decisions on patentability. *In re Raynes*, 7 F.3d 1037, 28 USPQ2d 1630 (Fed. Cir. 1993).

Unlike judicial notice,⁴³ official notice may be taken not only of a fact that is widely notorious but also of a fact that is capable of "instant and unquestionable demonstration."⁴⁴ *In re Ahlert*⁴⁵ provides an archetypical example of an instant and unquestionably demonstrable fact. *Ahlert* involved the patentability of claims specifying a technique for controlling the rate of cooling a weld between two sections of railroad rail. The technique produced a tough, crack-free weld having reduced internal stresses.⁴⁶

In affirming an Examiner's rejection of the claims, the Board took notice that it was common practice in the art of welding to postheat a weld after completing the corresponding welding operation. It also officially noticed the practice in the art of adjusting the intensity of a flame according to heat requirements.⁴⁷ On appeal, the applicant contested the propriety of the Board's notice, urging that the facts were "not so notorious and well known that any court would be justified in taking judicial notice thereof."⁴⁸ The CCPA was not persuaded. It upheld the right to take official notice of facts that "while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute."⁴⁹

*In re Perkins*⁵⁰ offers another example of an instant and unquestionably demonstrable fact.⁵¹ *Perkins* involved the patentability of claims specifying an alloy containing tantalum and titanium. Addition

provides an example of a widely notorious fact noticed by the court. In affirming a rejection of claims specifying an interactive automobile service station, the Federal Circuit took judicial notice of the "ubiquitous" use of video to display programming information and other information. *Id.* at 1040, 28 USPQ2d at 1632. The fact is notorious. Laymen frequently consult video screens for the arrival and departure times of trains or airplanes, for weather reports, or for stock quotes. See also *In re Wright*, 866 F.2d 422, 426, 9 USPQ2d 1649, 1652 (Fed. Cir. 1989) (taking notice of the "widespread" use of "carbonless paper" in manifold business forms).

43. Official notice is broader than judicial notice. Any matter capable of being judicially noticed also is capable of being officially noticed. The converse is not true. Officially noticed matters do not necessarily fall into categories that bring them within the confines of judicial notice. *MEZINES*, *supra* note 18, § 25.01, at n.4.

44. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (confusingly using the expression "judicial notice" rather than "official notice").

45. 424 F.2d 1088, 165 USPQ 418 (CCPA 1970).

46. *Id.* at 1089, 165 USPQ at 418-19.

47. *Id.* at 1090, 165 USPQ at 420.

48. *Id.* at 1091, 165 USPQ at 420.

49. *Id.*, 165 USPQ at 420.

50. 346 F.2d 981, 146 USPQ 63 (CCPA 1965).

51. There is room for reasonable minds to disagree over whether a particular fact is widely notorious or instantly and unquestionably demonstrable.

of titanium to tantalum produced improvements over the properties of unalloyed tantalum.⁵²

In affirming a rejection of the claims, the Board took notice that for many years tantalum had been worked into sheet and wire form and used for its corrosion resistance in the chemical industry.⁵³ The CCPA accepted this notice and affirmed the Board's decision.⁵⁴ Admittedly, this fact is not widely notorious. Many laymen do not know what tantalum is... not to mention its uses and properties. The fact, however, is instantly and unquestionably demonstrable by one of ordinary skill in the art.

The scope of official notice is not as broad as it might appear at first. The CCPA warned that it would construe narrowly the scope of facts that may be noticed and the conclusions that may be drawn from the facts.⁵⁵ *In re Spormann*⁵⁶ provides an example of this narrow construction. *Spormann* concerned the patentability of claims specifying a process for producing solid alkali metal sulfites from alkali metal hydroxides or carbonates. The process involved "spraying the latter, in an aqueous solution, into a dry gas containing sulfur dioxide, the temperature and humidity of the gas being such as to immediately vaporize the water to the end that very little sulfate is produced."⁵⁷

In affirming a rejection of the claims, the Board appeared to take notice that spray drying was an old expedient for obtaining a solute in dry form.⁵⁸ The CCPA reversed the rejection. "While we have heard of spray drying," the court commented, "it is not a technique of which we would feel free to take judicial notice."⁵⁹ The CCPA added "if the Patent Office⁶⁰ wishes to rely on what 'Those familiar with spray drying would know,' it must produce some reference showing what such knowledge consists of."⁶¹

Accordingly, an Examiner should exercise care in deciding whether a fact is amenable to official notice. He should not take notice

52. *Perkins*, 346 F.2d at 982, 146 USPQ at 64.

53. *Id.* at 984, 146 USPQ at 66.

54. *Id.*, 146 USPQ at 66.

55. *In re Pardo*, 684 F.2d 912, 917, 214 USPQ 673, 677 (CCPA 1982); *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). *But cf. In re Howard*, 394 F.2d 869, 872, 157 USPQ 615 (CCPA 1968) (Kirkpatrick, J., concurring) (observing that "the limits of judicial notice, particularly in patent cases, are expanding and the field of notice is now pretty broad.").

56. 363 F.2d 444, 447, 150 USPQ 449, 452 (CCPA 1966).

57. *Id.* at 444, 150 USPQ at 449 (emphasis omitted).

58. *Id.* at 447, 150 USPQ at 452.

59. *Id.*, 150 USPQ at 452.

60. Before 1975, the PTO was known as the Patent Office. *Barry, supra* note 34, at 845 n.35.

61. 363 F.2d at 447, 150 USPQ at 452.

of a fact normally subject to the possibility of rational disagreement among reasonable men.⁶² Facts constituting the state of the art, for example, are in this category.⁶³ If the Examiner has a "reasonable doubt" whether a fact may be noticed, he should not take notice of it.⁶⁴

III. USE OF OFFICIAL NOTICE

The CCPA has required that an applicant for a patent be "amply apprised" of a taking of official notice.⁶⁵ Accordingly, an Examiner should make clear when and for what he is relying on notice. The former can be accomplished by including the expression "official notice is taken" in an Office action.⁶⁶ The latter can be accomplished by mapping the exact and complete language of a pending claim to a noticed fact.⁶⁷

An Examiner bears the initial burden of presenting a *prima facie* conclusion of obviousness.⁶⁸ Although official notice relieves the Examiner from producing a reference to prove the existence of a well known fact,⁶⁹ it does not free him from the other requirements for establishing a *prima facie* conclusion.⁷⁰ Among these requirements are

62 *In re Eynde*, 480 F.2d 1364, 1370; 178 USPQ 470, 474 (CCPA 1973); *In re Barr*, 444 F.2d 588, 591 n.5, 170 USPQ 330, 334 n.5 (CCPA 1971).

63 *Eynde*, 480 F.2d at 1370, 178 USPQ at 474. Also in this category is "the skill of a person or ordinary skill in either computer programming or design in 1970," which was held to be not a proper subject for notice in 1982. *In re Pardo*, 684 F.2d 912, 917, 214 USPQ 673, 677 (CCPA 1982).

64 *Cf. Brown v. Piper*, 91 U.S. 37, 42-43 (1875) (regarding judicial notice).

65 *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 421 (CCPA 1970).

66 See PTO, TECHNOLOGY CTR. 2700, WORKGROUP 2760 TRAINING MANUAL 4-8 to 4-9, 4-11 (Sept. 25, 1998). An Office action is an official, written communication from the PTO to an applicant or his attorney that raises some objection, requirement, or rejection and includes a concise explanation of the reasons therefor. The Office action may also indicate any allowable subject matter. PETER D. ROSENBERG, PATENT LAW FUNDAMENTALS § 15.03[1] (2d ed. 1998 rev.).

67 *Cf. LANCE LEONARD BARRY ET AL., OBVIOUSNESS UNDER 35 U.S.C. 103, BASIC STUDENT'S MANUAL* 27 (Aug. 4, 1998) (instructing an Examiner to use "the complete and exact language of the claims" when writing a rejection).

68 *In re Piascecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). If the Examiner does not make a *prima facie* case, an applicant is under no obligation to submit evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Once the Examiner does produce a *prima facie* case, the burden of going forward with evidence shifts to the applicant. Piascecki, 745 F.2d at 1471-72, 223 USPQ at 788.

69 M.P.E.P. § 2144.03.

70 *Ex parte Grochowski*, No. 95-1343, at 5 (Bd. Pat. App. & Int. June 27, 1995) (observing "that just because elements are old and well known in the art does not render their combination obvious *per se*").

employing analogous art and identifying a suggestion for combining teachings. These requirements will be explained *seriatim*.

To qualify as prior art for obviousness, art must be analogous, i.e., in the field of an applicant's endeavor or reasonably pertinent to the particular problem with which the applicant was concerned.⁷¹ When writing a rejection employing official notice an Examiner should state that a fact being noticed was well known *in an analogous art* and should name the art.⁷² The Examiner should also state that the fact was well known at the time of the invention, i.e., at the time the patent application was filed.⁷³

Once it has been shown that a noticed fact could have been used because it was known in an analogous art, a suggestion, i.e., a motivation, must be shown for its proposed use. The suggestion must be based on more than the mere existence of the noticed fact.⁷⁴ The prior art as a whole must have contained something to suggest the "desirability" of using the noticed fact to modify a prior art reference.⁷⁵ An Examiner accordingly must explain a suggestion for employing the noticed fact in a rejection.⁷⁶

When the decision of an administrative agency such as the PTO rests on official notice of a fact, a party is entitled to challenge the notice.⁷⁷ If an applicant for a patent does not "seasonably" traverse a fact officially noticed during examination, it becomes an admission of prior art.⁷⁸ A seasonable challenge is "a demand for evidence made as

71 *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

72 See, e.g., *Lucerne Prods., Inc. v. Outler-Hammer, Inc.*, 568 F.2d 784, 798, 195 USPQ 472, 481 (6th Cir. 1977) (taking notice of the fact that the principles of camming, pivoting and bridging were well known "in the mechanical arts").

73 The appellant of *In re Lewis*, 96 F.2d 1009, 37 USPQ 786 (CCPA 1938), argued that the Board's expression that a broadcasting practice was "now well known in the art" should be construed to mean that the practice was known at the time the Board wrote its opinion. The CCPA declined to do so. The court instead interpreted the expression as meaning that the practice was known at the time the appellant's application was filed. *Id.* at 1011; 37 USPQ at 788. It is better to preclude such an argument by stating that a fact was well known at the time of the invention.

74 *Grochowski*, No. 95-1343, at 5.

75 *Lindemann Maschinenfabrik GMBH v. American Host and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

76 *Cf. BARRY*, *supra* note 67, at 27 (instructing an Examiner to explain a suggestion/motivation for modifying references used in a rejection).

77 See Administrative Procedure Act, 5 U.S.C. § 556(c) (1996).

78 M.P.E.P. § 2144.03. *Cf. In re Gunther*, 125 F.2d 1020, 1023, 52 USPQ 465, 468 (CCPA 1942) (accepting a statement by an Examiner of what was well known in the art because an applicant failed to challenge the statement "before the Patent Office."); *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) (refusing to consider an appellant's statement in his brief because *inter alia* the appellant failed to demand that an Examiner produce authority for his statement); *In re Lundberg*, 244 F.2d 543, 551, 113 USPQ 530, 537 (CCPA 1957) ("[T]he board

soon as practicable during prosecution.⁷⁹ An applicant is charged with rebutting a taking of notice in the response to the Office action in which the notice was taken.⁸⁰

A challenge may take the form of a demand for evidence that a noticed fact was well known.⁸¹ If an applicant demands such evidence, an Examiner should cite a reference showing the fact in the next Office action.⁸² Such a citation is unnecessary if the applicant does not challenge the notice.⁸³ If the reference is cited *only* as evidence of the prior official notice, its addition does not amount to a new ground of rejection.⁸⁴ Barring any other impediments to finality,⁸⁵ the Office action may be made final.⁸⁶

CONCLUSION

This note sought to increase understanding of official notice in three parts. The first part explained that the rationale for official notice was twofold. Notice helps an Examiner use his limited time efficiently and permits him to rely on his scientific or engineering expertise. The second part addressed the scope of official notice. It explained that the Examiner may take notice of a fact that is widely notorious or is instantly and unquestionably demonstrable.

It stated that the use of feedback members in electrical circuits [was] well known. Appellants have failed to question the accuracy of the statement... and did not present any evidence to contradict it. Therefore we are constrained to accept it as true."').

⁷⁹ M.P.E.P. § 2144.03.

⁸⁰ *Id.*

⁸¹ *Id.* The CCPA has stated that a challenge to notice taken by the Board must contain adequate information or argument to create *on its face* a reasonable doubt about the propriety of the notice. *In re Boon*, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA 1971). At least one patent practitioner, moreover, has advised that an applicant challenging notice taken by an Examiner should include affidavit evidence by a person skilled in the specific art relating to the patent application. DONNER, *supra* note 28, at 195.

⁸² M.P.E.P. § 2144.03.

⁸³ *In re Sun*, 31 USPQ2d 1451, 1454 (Fed. Cir. 1993).

⁸⁴ See *Boon*, 439 F.2d at 727-28, 169 USPQ at 234.

⁸⁵ A second or subsequent Office action on the merits shall be final unless an Examiner has introduced a new ground of rejection that is neither necessitated by an applicant's amendment of claims nor based on information submitted in an information disclosure statement (IDS) filed during the period set forth in 37 C.F.R. § 1.97(c). Where information is submitted in an IDS during the period, the Examiner may use the information submitted and still make the next Office action final regardless of whether the claims have been amended, provided that he introduces no other new ground of rejection that was not necessitated by amendment to the claims. A second or subsequent action on the merits in any application will not be made final, furthermore, if it includes a rejection on newly cited art, other than information submitted in an IDS filed under § 1.97(c), of any claim not amended by the applicant regardless of the fact that other claims may have been amended to require newly cited art. M.P.E.P. § 706.07(a).

⁸⁶ *Id.* at § 2144.03; see also PTO, *supra* note 66, at 4-8.

The third part outlined the use of official notice. It explained that the Examiner should make clear when and for what he is relying on notice. He should also ensure that a noticed fact was well known in an analogous art and that a suggestion existed for using it. The third part also explained that in response to an applicant's seasonable challenge of the taking of notice, the Examiner should cite a reference showing the noticed fact in the next Office action. Barring any other impediments to finality, the Examiner should still make the action final. Armed with the knowledge provided in this note Examiners should have a greater understanding of when and how to use official notice... and a new insight into the comedy of Jerry Seinfeld!

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EXAMINER AFFIDAVIT SUPPORTING OBVIOUSNESS REJECTION

Claims 32-70 are an obvious variation over examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

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generating a purchase incentive based on said discount items. Examiner also has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased. The dependently claimed steps including instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification are also services and features available using

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PerformanceBike based on examiner's experience. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious to one skilled in the art to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known as discussed above. The motivation to combine applicants claimed invention with the services offered by PerformanceBike is to allow advertisers greater consumer targeting capabilities, while transferring information, which clearly shows the obviousness of the claimed invention.

I hereby declare that all statements made under this declaration of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 USC 1001 and that such will false statements may jeopardize the validity of the application or any patent issued thereon.

Steve Ghavini

The following is a quotation of 35 USC 102(b):

A person shall be entitled to a patent unless the invention was patented or described in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

In reply, the applicants point out that neither Walker et al. (USP 5,945,653), Jermyn (USP 6,026,370), Mori et al. (USP 6,070,148), Katz et al. (USP 6,055,513), Giuliani (USP 6,282,516), Kepecs (USP 6,330,543), Meyer et al. (WO 99/46708), and Day et al. (US Patent Publication 2001/0013011) were all published after March 16, 1999, which is one year prior to this application's 35 USC 120 benefit date. Therefore, none of the eight references are 102(b) prior art. Therefore, the rejections of claims 1-74 under 102(b) are improper and should be reversed.

b. No Prima Facie Showing of Anticipation for Any of the 16 References

The examiner made no showing that any of the 16 references cited under 35 USC 102 disclose any one of the claimed inventions.³ Therefore, the rejections are all improper and should be reversed.

4. 37 CFR 1.192(c)(8)(iv) - 35 USC 103 Rejection of Claims 1-74

a. Summary

The examiner rejects claims 1-74 under 35 USC 103(a) based upon his alleged personal knowledge⁴, asserting that:

Claims 1-74 are rejected under 35 USC 103(a) as being unpatentable over an obvious variation of examiner's personal experience of a method or system of targeted research information as provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method or system comprising:

receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location;

³See In re Lee, infra.

⁴The examiner gave a declaration supporting the obviousness rejection. See attachment 9, which is a copy of the declaration.

determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research information including contact information to be used by the customer to participate in marketing research; and

delivering the targeted research invitation to the customer including a memory device and processor configured to perform the method steps thereof. Examiner also has personal knowledge of the claimed prior purchase history basis received at a host computer, storing and matching customer and point of sale information, participation incentives, unique code numbers, printed research invitations at the point of sale, scanning customer identification information, customer contact information, purchase triggers including comparison, product information receipt, and multiple points of sale including credit/debit/social security card, driver's license, or checking account scanning. The claimed receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location occurs when the examiner presented a Team Performance loyalty customer identification card at a point of sale PerformanceBike retail location that provided a basis for examiner's purchase information and history. The claimed determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research invitation including contact information to be used by the customer to participate in marketing research occurs when the examiner was presented with periodic PerformanceBike sale items based on prior purchases such that examiner was targeted with bicycling products most relevant to examiner's prior purchases, the Team Performance card included examiner's customer identifier. Examiner uses a broad reasonable interpretation of "targeted research invitation" to be the same as PerformanceBike offers of tricycles, training wheels, children's safety equipment including helmets, knee and elbow pads, and bicycle flags based on examiner's prior purchase of a bicycling trailer for towing children on a bicycle. (Another interpretation will be considered for obviating the claimed invention *infra*). The claimed delivering the targeted research invitation to the customer including a memory device and processor configured to perform the method steps thereof occurs when the examiner was mailed (electronically or postally) offers of children's cycling equipment at discount or reduced pricing. PerformanceBike used a computer for the claimed prior purchase history basis received at a host computer, storing and matching customer and point of sale information, participation incentives, unique code numbers, printed research invitations at the point of sale, scanning customer identification information, customer contact information, purchase triggers including comparison, product information receipt, and multiple points of sale including credit/debit/social security card, driver's license, or checking account scanning. Examiner notes that it is old and well known to those skilled in the art of targeted research invitation, that it would have been obvious to claim the invention as recited by the applicant, in order to

overcome the explicit teachings of examiner's personal experience discussed supra. Furthermore examiner experience teaches the claimed invention except for the claimed targeted research invitation (as another interpretation). Examiner considers the claimed targeted research invitation to be merely an obvious variation of the marketing technique used by PerformanceBike to target customers with specific products or services. Although examiner has never heard this marketing technique to be recited as "targeted research invitation" it is not patentably distinct using broadest reasonable interpretations under the *Graham* decision. It would have been obvious to one skilled in the art to provide targeted research invitation since that marketing technique is merely an automated features [sic] of a concept that is old and well known. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The targeted research invitation is merely an automatic or mechanical means to replace an [sic] manual activity based on examiner's personal experience with the claimed method or system comprising: receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location; determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research invitation including contact information to be used by the customer to participate in marketing research; and delivering the targeted research invitation to the customer including a memory device and processor configured to perform the method steps thereof. The motivation to combine applicants [sic] claimed invention with the services offered by PerformanceBike in order is to allow advertisers, manufacturers, retailers, and consumer advocacy groups greater consumer targeting capabilities for increased sales and to deliver consumer products that are more likely to be well received by the public, which clearly shows the obviousness of the claimed invention.

In reply, the applicants respectfully traverse these rejections because they fail to carry the burdens of proof and persuasion in view of the evidence and reasoning presented below.

b. No Physical Evidence Supports the Assertions in the Examiner's Declaration that the PerformanceBike.com Web Site Existed in 1994

The examiner alleges personal knowledge of the existence of the PerformanceBike.com web site of "[s]ince at least 1994." This allegation, even though asserted now by the examiner in a declaration, fails to carry the burden of proof as to the existence of the PerformanceBike.com web site prior to the applicant's priority filing date, i.e., prima facie date of invention.

The applicants first point out that there is no physical evidence supporting the examiner's

assertions that the Performancebike.com web site existed in 1994. In fact, the printout of the WAYBACK MACHINE for PerformanceBike.com as of December 24, 1997⁵ shows a copyright year of 1997, which is the prima facie date associated with that website. Accordingly, that physical evidence is not evidence of prior art.

Submitted with this brief is probative physical evidence that no version of the www.PerformanceBike.com web site existed until some time in 1997, and certainly no later than December of 1996.

i. The Web Master for PerformanceBike.com Indicated That the First PerformanceBike.com Web Site Was Launched in Late 1996

I spoke with the web master of performance bike on 9/19/02, via telephone. The web master is Andrew Ruggeri, telephone number 800-433-1633 (at an internal company extension of that number). Mr. Ruggeri clearly indicated to me (1) that he knew that the first web site for Performance Bike was launched in *August or September of 1996*, (2) that he became an employee of Performance Bike in 1997, and (3) that he knew that the Performance Bike web site has never provided coupons for retail store purchases. Mr. Ruggeri indicated that one reason the web site has never provided coupons for retail store purchases was that the pricing structure for web based sales and retail store sales were different, and therefore, placing incentives for retail store purchase on the website would be incompatible with the distinct pricing for web site sales and retail store sales.

I attempted to get a declaration from Mr. Andrew Ruggeri, but his company referred me to its outside IP counsel, Christopher Bolen, Esq., and Mr. Bolen refused my requests. Third party discovery is not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that evidence, if and when it becomes available.

ii. Physical Evidence Indicates That The PerformanceBike.com Web Site Came into Existence in Late 1997

⁵A copy of the printout of 8 pages of the PerformanceBike.com website from December 24, 1997 is attachment 8.

A ten-page printout at URL www.archive.org/about/about.php describing the WAYBACK MACHINE is submitted herewith.⁶ A five page printout of the URL www.archive.org is submitted herewith.⁷ A two page printout of the URL pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 is submitted herewith.⁸ As indicated in those attachments, www.archive.org is run by the "Internet Archive", which is a non profit library organization dedicated to archiving the Internet. The Internet Archive has been receiving data regarding the web from "Alexa", which is a company that runs a 'web crawler.' A web crawler is a computer system that downloads and reviews all of the high level URLs for content on a periodic basis, for indexing their content for use by search engines.

The WAYBACK MACHINE is a web enabled interface between the Internet Archive's data store that enables anyone with a web browser to see what certain web sites looked like on prior dates. See attachment 2.

Moreover, the Director of the USPTO via his delegees has instructed the examiners to rely upon the Wayback Machine to prove web site prior art dates and content on those dates. The USPTO hosted a "Business Methods Partnership Meeting" on April 1, 2003, which was open to the public. At this meeting, Jim Trammell, Supervisory Patent Examiner, TC 3600, and Bob Weinhardt, Quality Assurance Specialist, TC 3600, gave the presentation entitled "When is an Electronic Document a Printed Publication for Prior Art Purposes?"⁹ The presenters in particular identified the "Wayback Machine" as among the "Resources Used by Examiners to Establish Website Dates."¹⁰ The presenters stated that the Wayback Machine "[f]inds archived web pages

⁶A copy of the ten page printout of www.archive.org/about/about.php is attachment 1\.

⁷A copy of the five page printout of www.archive.org is attachment 2.

⁸A copy of the two page printout of pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 is attachment 3.

⁹A Copy of the presentation "When is an Electronic Document a Printed Publication for Prior Art Purposes?" is attachment 12. This presentation was made as part of the USPTO's "Business Methods Partnership Meeting" with the public, held April 1, 2003.

¹⁰Slide 25 from attachment 12.

back to 1996."¹¹ The presenters made it quite clear that the USPTO's examiners are relying on Wayback Machine archive dates as evidence showing prior art dates for websites. Thus, the applicants' use of the Wayback Machine herein should be accorded equal respect.

I used the WAYBACK MACHINE to see what versions of the PerformanceBike.com web site existed at prior dates. Specifically, I used the WAYBACK MACHINE's search function for <http://performancebike.com> on November 27, 2002. My results are attachment 4.¹² The search result shows that PerformanceBike.com web site was not launched until October 1997. Specifically, attachment 4 states "0 pages" under the heading 1996, which strongly suggests that, although the URL domain name was registered with the domain name register in 1996, no web pages were associated with the logical address www.PerformanceBike.com in 1996 that could be downloaded to a user's computer via use of a web browser until after 1996. In contrast, attachment 4 shows web pages associated with www.PerformanceBike.com beginning October 17, 1997, and web pages continuously associated with that URL ever since. This evidence implies that the www.PerformanceBike.com web site, that is, a URL which would transmit web pages to a user, did not exist prior to the priority filing date for this application.

The most recent version of the PerformanceBike.com web site in the WAYBACK MACHINE prior to March 16, 2000 is on November 15, 1999. A copy of the printout of the WAYBACK MACHINE for PerformanceBike.com on November 15, 1999 is attachment 13.¹³ That version does not show any of the targeted research invitation limitations defined by claims 1-74.

I attempted to get a declaration from a representative of the Internet Archive. However, their representative referred me to their counsel, which is Rachel Silvers of the firm of Perkins Coie LLP in San Francisco. Ms. Silvers indicated that the Internet Archive refused to provide a declaration explaining the meaning of the "1996 0 pages" text in attachment 4. Third party

¹¹Slides 27-29 from attachment 12.

¹²A Copy of the printout of the WAYBACK MACHINE'S search result for <http://performancebike.com> conducted on November 27, 2002 is attachment 4.

¹³A copy of the printout of 13 pages of the PerformanceBike.com web site from November 15, 1999, as stored in the WAYBACK MACHINE is attachment 13.

discovery is not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that evidence, if and when it becomes available.

iii. **The www.PerformanceBike.com Domain Name Was Not Even Registered Until December 3, 1996**

Network Solutions, Inc. was founded in 1979 and is located in Herndon, Virginia. Until recently, in 1999, Network Solutions, Inc. ("NSI") was the only registrar of domain names for the web. www.netsol.com is NSI's web site.¹⁴ It contains a WHOIS search engine.

This type of search engine provides users information related to a particular web site, such as registrant name, date of initial registration, and date of most recent update.

I conducted a search for www.PerformanceBike.com on the WHOIS search engine at www.netsol.com on December 2, 2002. A printout of the WHOIS search result for www.PerformanceBike.com from www.netsol.com WHOIS search engine is submitted herewith as attachment 7.¹⁵ The search result shows that the domain name www.PerformanceBike.com was not registered until December 3, 1996.

When a domain name is registered, it is by contract, controlled by the entity that purchased it. It does not automatically have web pages, i.e., a web site, associated with it. Therefore, the mere fact that www.PerformanceBike.com was registered on December 3, 1996, does not imply that a web site, i.e., content available for downloading to a user's browser, existed on that date. In fact, complicated web sites often take months to develop before they are ready for loading onto the Web as a web site.

I attempted to get a declaration from a representative of NSI explaining that the date listed in their WHOIS search engine is the date that a domain name was first registered in the master Domain Name Service hosted by NSI and therefore the earliest date on which the domain

¹⁴A copy of the printout from www.verisign.com/corporate/news/apr_19980107.html describing Network Solutions, Inc., is attachment 5. A copy of www.wired.com/news/politics/0,1238,31551,00.html is attachment 6.

¹⁵A copy of the printout from www.netsol.com's WHOIS search engine for www.PerformanceBike.com is attachment 7.

name would have been available for hosting a web site.

A representative of NSI verbally indicated to me that NSI only accepted subpoena's for testimony via FAX, and that NSI did not respond to voluntary requests for discovery. Third party discover in not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that evidence, if and when it becomes available.

c. **The Weight of the Evidence is that the PerformanceBike.com Web Site did not Exist in 1994**

All of the above listed physical evidence is contradictory to the assertions provided in the examiner's declaration as to the date of existence of the PerformanceBike.com web site, and to the assertion that the web site is legal prior art.¹⁶ The APJs must compare the weight of the physical evidence indicating that the web site did not exist until 1997 to the examiner's recollection that the web site existed in 1994. I submit that the examiner's unsupported recollection is clearly outweighed by the weight of the physical evidence and the information Mr. Ruggieri passed along to me.

d. **Objectively Implausible Nature of Factual Assertions in the Examiner's Declaration**

The examiner made blanket statements in his declaration that each and every limitation claimed in claims 1-74 were known to him since 1994. In fact, the examiner has made the same type of blanket statement in rejecting all claims in attorney docket CAT/29US-SCROCO, application number 09/401,939, and all claims in CAT/29US-SCRO-CO3, application number 09/756,788, which are also now on appeal¹⁷. The examiner's allegations that so many limitations in so many claims were personally known to him are objectively implausible. For this reason, the examiner's declaration should be given little or no probative weight.

¹⁶ A copy of the 4 page examiner affidavit supporting obviousness rejection is attachment 9.

¹⁷ A copy of the claims in application number 09/401,939 is attachment 10 to this brief. A copy of the claims in application number 09/756,788 is attachment 11 to this brief.

e. **The PerformanceBike.com Web Site Did Not In Fact Anticipate or Suggest Any One of Claims 1-74**

The applicants point out that the evidence shows that PerformanceBike.com web site does not now and did not prior to 2000 determine, based on information received at a point of sale, a targeted research invitation associated with a customer identifier and deliver the targeted research invitation to the customer, contrary to the examiner's assertion. The most recent version of the PerformanceBike.com web site prior to March 16, 2000 is on November 15, 1999. A copy of the printout of the WAYBACK MACHINE for PerformanceBike.com on that date is attachment 13.¹⁸ Attachment 13 shows a web site which has none of the functionality, nor discloses or appears to show any of the targeted research invitation limitations defined by claims 1-74.

There is highly probative evidence that the alleged prior art upon which the examiner relies did not exist prior to 2000, i.e., did not exist prior to the priority date for the claims in this application. For this additional reason, the rejections based upon the examiner's declaration should be reversed.

f. **The Examiner's Assertions Are not Specific as to Observed Activity, Place, and Time**

The examiner's assertions in support of the 35 USC 103 rejections in the office action dated December 18, 2002 are not specific as to observed activity, place, and time. The examiner asserts in his declaration that Performance Bike disclosed the claimed inventions, by stating that:

Since at least 1994, PerformanceBike has performed the claimed method or system comprising:

receiving from a point of sale a customer identifier (or purchase information, or purchase history of a customer) associated with a customer in a retail location;

determining a targeted research invitation associated with the customer identifier (or purchase information, or purchase history of a customer), the targeted research invitation including contact information to be used by the customer to participate in marketing research; and

delivering the targeted research invitation to the customer including a

¹⁸A copy of the printout of the WAYBACK MACHINE for PerformanceBike.com on November 15, 1999 is attachment 13.

memory device and processor configured to perform the method steps thereof. Examiner also has personal knowledge of the claimed prior purchase history basis received at a host computer, storing and matching customer and point of sale information, participation incentives, unique code numbers, printed research invitations at the point of sale, scanning customer identification information, customer contact information, purchase triggers including comparison, product information receipt, and multiple points of sale including credit/debit/social security card, driver's license, or checking account scanning. [Office action mailed 12/18/02 page 11 lines 6-18.]

The examiner's assertions are not backed up by any specificity. No specific time, place, or event is alleged in the examiner's declaration. Specificity is an important factor in determining probative value of any statement. "The lack of specificity deprives the appellant of a suitable rebuttal and makes the rejection vague and uncertain on review. Absent sufficient findings, it cannot be said that the examiner has sufficiently made out a prima facie case of obviousness." Ex parte Marckini (Appeal No. 97-3671, Application 08/266,977 at <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd973671.pdf> at page 9) (not binding precedent). Furthermore, the examiner has the burden to establish a prima facie case of obviousness. The examiner is required to establish a factual basis to support obviousness conclusion. In re Fine, 837 F.2d 1071, ___, 5 USPQ 2d 1596, 1988. Since the examiner has not provided specificity as to time, place, and event of any relevant prior public use, the rejections based upon the examiner's declaration (1) do not make out a prima facie case and (2) are improper and therefore should be reversed.

g. Claims 1-74 Also Distinguish Over the Examiner's Alleged Personal Experience with Performance Bike

The applicants submit that claims 1-74 also distinguish over the examiner's alleged personal experience with Performance Bike because the description in the official action of this experience is directed to sending to consumers offers of products related to a consumers' purchases. The examiner's personal experience described in the official action does not include the research invitation recited in the applicants' claims and described in the disclosure, for example, based on the consumer's prior purchases, sending the consumer an invitation to receive a marketing questionnaire. This is because the examiner's apparent definition of "targeted

research invitation,” which is a limitation contained in each of claims 1-74, differs from the definition of “targeted research invitation” disclosed in the specification

The examiner states his definition of targeted research invitation in the office action mailed December 18, 2002 as follows:

Examiner uses a broad reasonable interpretation of “targeted research invitation” to be the same as PerformanceBike offers of tricycles, training wheels, children’s safety equipment including helmets, knee and elbow pads, and bicycle flags based on examiner’s prior purchase of a bicycling trailer for towing children on a bicycle. [Page 6 lines 1-4, office action mailed December 18, 2002.]

The examiner further clarifies his definition of targeted research invitation in the office action mailed December 18, 2002:

Examiner considers the claimed targeted research invitation to be merely an obvious variation of the marketing technique used by PerformanceBike to target customers with specific products or services. Although examiner has never heard this marketing technique to be recited as “targeted research invitation” it is not patentably distinct using broadest reasonable interpretations under the Graham decision. It would have been obvious to one skilled in the art to provide targeted research invitation since that marketing technique is merely an automated features [sic] of a concept that is old and well known. [Page 6 line 18 through page 7 line 5, office action mailed December 18, 2002.]

[I]t is old and well known to those skilled in the art of targeted research invitation, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner’s personal experience discussed supra. Furthermore examiner experience teaches the claimed invention except for the claimed targeted research invitation (as another interpretation). Examiner considers the claimed targeted research invitation to be merely an obvious variation of the marketing technique used by Performance Bike to target customers with specific products or services. [Office Action mailed 12/18/02 page 13 lines 1 - 8.]

Thus, the examiner construes offers for sale of bicycle equipment to be “targeted research invitations.”

In reply, the applicants point out that the examiner’s interpretation of “targeted research invitation” is inconsistent with the meaning of “targeted research invitation” defined by the applicants’ specification. The specification defines “targeted research invitation” to mean giving a research invitation to a specific consumer specifically based on the consumer’s purchase

history, wherein the research invitation includes contact information to be used by the consumer to participate in marketing research, and may include an incentive for the consumer to participate in the research, as clearly defined by page 2 line 7 to page 3 line 2 of the specification, which states that:

Accordingly, one object of this invention is to target research invitations to specific consumers, based on the consumers' purchase histories.

Another object of the present invention is to provide a novel method and system for delivering targeted research invitations to consumers at points of sale in retail locations.

These and other objects are achieved by providing a novel method, system, and computer program product for delivering targeted research invitations. The method, on which the system and computer program product are based, includes the steps of: receiving from a point of sale a customer identifier associated with a customer in a retail location; determining a targeted research invitation associated with the customer identifier, the targeted research invitation including contact information to be used by the customer to participate in marketing research; and delivering the targeted research invitation to the customer.

According to another aspect of the invention, targeted research invitations are determined based on purchase information of at least one item purchased in the retail location. Preferably, purchase triggers, such as predetermined bar code information (e.g., UPC, JAN, and/or EAN information), are used to determine when targeted research invitations should be delivered to the customer. The purchase triggers may be used in place of, or in addition to, the customer identifiers in determining targeted research invitations to be delivered to the customer.

According to another aspect of the present invention, purchase history information of a consumer is stored. The purchase history information includes information of items purchased by the consumer. A targeted research invitation is determined based on the purchase history information, the targeted research invitation including contact information to be used by the consumer to participate in marketing research and an incentive to induce the consumer to participate in the marketing research. The targeted research invitation is then associated with a customer identifier associated with the consumer. [Underlining added.]

The examiner's interpretation is inconsistent with the specification because PerformanceBike's sale of bicycle equipment is not an invitation to participate in marketing research, with or without an incentive.

The examiner also alleges that the claimed inventions are obvious, stating that:

Examiner notes that it is old and well known to those skilled in the art of targeted

research invitation, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner's personal experience discussed supra. Furthermore examiner experience teaches the claimed invention except for the claimed targeted research invitation (as another interpretation). Examiner considers the claimed targeted research invitation to be merely an obvious variation of the marketing technique used by PerformanceBike to target customers with specific products or services. [Page 13 lines 1-8 Official Action Mailed December 18, 2002.]

In reply to this alternative argument, applicants submit that the mere fact that the prior art that the examiner declared he "experienced" via Performance Bike.com could be modified would not have made such a modification obvious, absent some teaching in the prior art motivating the modification of the prior art. In re Deminski, 796 F.2d 436, 230 USPQ 3113 (Fed. Cir. 1986). What the examiner "considers merely an obvious variation" is not probative. Performance Bike provides no teaching suggesting the research incentives recited in the applicants' claims. Therefore, the rejections of claims 1-74 relying upon the examiner's experience with Performance Bike are improper and should be reversed.

5. 37 CFR 1.192(c)(8)(v) - Other Rejections

a. Sixth Paragraph 35 USC 112 Rejections of Claims 48-74

The examiner rejects claims 48-74 under 35 USC 112, sixth paragraph, stating that:

Claims 48-74 are rejected under 35 USC 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see *In re Donaldson Co.*, 16 F.2d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994)). The independently claimed "means for" steps are not construed means-plus-function language under the rubric of reasonable interpretation, because neither the specification nor the claims provide a clear limit of patentability. Each independently claimed "means for" step is merely exemplified after that recitation with functional language but not modified by sufficient structure, material, or acts for achieving the specified function and as such, may incorporate any function that could be taught in the prior art, as will be illustrated and discussed under the prior art rejections infra. In order to consider that claim in light of the prior art, examiner will assume that those claims contain a clear limitation under the broadest reasonable interpretation. [Office action mailed 12/18/02 page 2 lines 9-19.]

In response, the applicants respectfully traverse these rejections because they are improper and should be reversed.

First, 35 USC 112, sixth paragraph does not define a requirement with which the

generating transmitting, and identifying token data in a retail store for discounted purchase from a main computer. In other words the invention as claimed communicates two different types of data between a main and personal computer with one of the types of data used to provide a basis for a third type of data.

Applicants argue that Day does not disclose the non enabling and indefinite features rejected above along with the claimed token data (one of two types of data) being transmitted back to the main from personal computer and retail store identification for generating a purchase incentive or third type of data. Applicants also argue that con Kohorn does not disclose an online distribution of data claimed as purchase incentives or a two-way interactive user retailer system. Applicants further argue that Deaton does not disclose the distribution of coupons or similar incentives. Applicants finally argue that Ferguson does not disclose generation of a third type of data or [token] data dependent upon one of two types of data between a main and personal computer with one of the types of data used to provide a basis for a third type of data. Each of the clearly anticipated references disclose the claimed invention on the face of each reference and examiner maintains the rejection based on applicants claimed invention and supporting arguments. [Office action dated 11/22/02 page 13 line 7 through page 14 line 13.]

In reply, the applicants respectfully point out that the foregoing statements do not provide any additional reasoning or assertions of fact in support of any rejection.

4. **37 CFR 1.192(c)(8)(iv) - 35 USC 103**

The examiner rejected claims 32-70 under 35 USC 103(a) based upon his alleged personal knowledge, declaring that¹:

Claims 32-70 are rejected under 35 USC 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selections data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

¹The examiner gave a declaration reciting what is quoted here. See attachment 9, which is a copy of the declaration.

generating token data depending on said selection data;
transmitting said token data from said main computer to said personal computer over said computer network;
identifying said token data in a retail store in association with items being purchased at said retail store;
determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items. Examiner also has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased. The dependently claimed steps including instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification are also services and features available using PerformanceBike based on examiner's experience. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious to one skilled in the art to provide

a personal computer display since the computer display is merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art)[sinc]. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities, while transferring information, which clearly shows the obviousness of the claimed invention. [Office action mailed 11/22/02 page 6 line 11 through page 9 line 6.]

In reply, the applicants respectfully traverse these rejections because they are not supported by any substantial evidence, and because they fail to carry the burdens of proof and persuasion. The examiner alleges personal knowledge of the existence of the PerformanceBike.com web site of “[s]ince at least 1994.” This allegation, even though asserted now by the examiner in a declaration, fail to carry the burden of proof as to the existence of the PerformanceBike.com web site prior to the applicant's priority filing date, i.e., prima facie date of invention.

a. No Physical Evidence Supports the Examiner's Declaration

That applicant first points out that there is no physical evidence supporting the examiner's assertions that the Performancebike.com web site existed in 1994. In fact, the PerformanceBike.com website printout enclosed with the July 29, 2002 office action shows a copyright year of 2000, which is the prima facie date associated with that website. Accordingly, no physical evidence supports the examiner's assertion that any performancebike.com web site existed prior to the priority date for this application.

b. Probative Evidence Exists That The PerformanceBike.com Web Site Did Not Exist In 1994

Submitted with this Brief is probative physical evidence that the www.PerformanceBike.com web site did not exist until some time in 1997, and certainly no later than December of 1996.

i. The Web Master for PerformanceBike.com Indicated That the First PerformanceBike.com Web Site Was Launched in Late 1996

I spoke with the web master of performance bike on 9/19/02, via telephone. The web master is Andrew Ruggeri, telephone number 800-433-1633 (at an internal company extension of that number). Mr. Ruggeri clearly indicated to me (1) that he knew that the first web site for Performance Bike was launched in *August or September of 1996*, (2) that he became an employee of Performance Bike in 1997, and (3) that he knew that the Performance Bike web site has never provided coupons for retail store purchases. Mr. Ruggeri indicated that one reason the web site has never provided coupons for retail store purchases was that the pricing structure for web based sales and retail store sales were different, and therefore, placing incentives for retail store purchase on the website would be incompatible with the distinct pricing for web site sales and retail store sales.

I attempt to get a declaration from Mr. Andrew Ruggeri, but his company resisted my request, and referred me to their outside IP counsel, Christopher Bolen, Esq. Third party discover in not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that such evidence, if and when it becomes available.

ii. **Physical Evidence Indicates That The PerformanceBike.com Web Site Came into Existence in Late 1997**

A ten-page printout at URL www.archive.org/about/about.php describing the WAYBACK MACHINE is submitted herewith.² A five page printout of the URL www.archive.org is submitted herewith.³ A two page printout of the URL pages.alex.com/company/index.html?p=Dest_W_t_40_B1 is submitted herewith.⁴ As indicated in those attachments, www.archive.org is run by the "Internet Archive", which is a non profit library organization dedicated to archiving the Internet. The Internet Archive has been receiving

²A copy of the ten page printout of www.archive.org/about/about.php is attachment 1.

³A copy of the five page printout of www.archive.org is attachment 2.

⁴A copy of the two page printout of pages.alex.com/company/index.html?p=Dest_W_t_40_B1 is attachment 3.

data regarding the web from "Alexa", which is a company that runs a 'web crawler.' A web crawler is a computer system that downloads and reviews all of the high level URLs for content on a periodic basis, for indexing their content for use by search engines.

The WAYBACK MACHINE is a web enabled interface between the Internet Archive's data store that enables anyone with a web browser to see what certain web sites looked like on prior dates. See attachment 2.

I used the WAYBACK MACHINE to see what versions of the PerformanceBike.com web site existed at prior dates. Specifically, I used the WAYBACK MACHINE's search function for <http://performancebike.com> on November 27, 2002. My results are attachment 4.⁵ The search result shows that PerformanceBike.com web site was not launched until October 1997. Specifically, attachment 4 states "no pages" in 1996, which means that the URL domain name was registered with the domain name register in 1996, but that no web pages were associated with the logical address www.PerformanceBike.com in 1996 that could be downloaded to a user's computer via use of a web browser. In contrast, attachment 4 shows web pages associated with www.PerformanceBike.com beginning October 17, 1997, and web pages continuously associated with that URL ever since. This means that the www.PerformanceBike.com web site, that is, a URL which would transmit web pages to a user, did not exist prior to the priority filing date for this application.

I attempted to get a declaration from a representative of the Internet Archive. However, their representative referred me to their counsel, which is Rachel Silvers of the firm of Perkins Coie LLP in San Francisco. Ms. Silvers indicated that the Internet Archive refused to provide a declaration explaining the meaning of the "1996 no pages" text in attachment 4. Third party discover in not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that such evidence, if and when it becomes available.

iii. **The www.PerformanceBike.com Domain Name Was**

⁵A Copy of the printout of the WAYBACK MACHINE'S search result for <http://performancebike.com> conducted on November 27, 2002 is attachment 4.

Not Even Registered Until December 3, 1996

Network Solutions, Inc. was founded in 1979 and is located in Herndon, Virginia. Until recently, in 1999, Network Solutions, Inc. ("NSI") was the only registrar of domain names for the web. www.netsol.com is NSI's web site.⁶ It contains a WHOIS search engine.

This type of search engine provides users information related to a particular web site, such as registrant name, date of initial registration, and date of most recent update.

I conducted a search for www.PerformanceBike.com on the WHOIS search engine at www.netsol.com on December 2, 2002. A printout of the WHOIS search result for www.PerformanceBike.com from www.netsol.com WHOIS search engine is submitted herewith as attachment 7.⁷ The search result shows that the domain name www.PerformanceBike.com was not registered until December 3, 1996.

When a domain name is registered, it is by contract, controlled by the entity that purchased it. It does not automatically have web pages, i.e., a web site, associated with it. Therefore, the mere fact that www.PerformanceBike.com was registered on December 3, 1996, does not imply that a web site, i.e., content available for downloading to a user's browser, existed on that date. In fact, complicated web sites often take months to develop before they are ready for loading onto the web as a web site.

I attempted to get a declaration from a representative of NSI explaining that the date listed in their WHOIS search engine is the date that a domain name was first registered in the master Domain Name Service hosted by NSI and therefore the earliest date on which the domain name would have been available for hosting a web site.

A representative of NSI verbally indicated to me that NSI only accepted subpoena's for testimony via FAX, and that NSI did not respond to voluntary requests for discovery. Third party discover in not available for ex parte matters, and therefore I do not have the right to

⁶A copy of the printout from www.verisign.com/corporate/news/apr_19980107.html describing Network Solutions, Inc., is attachment 5. A copy of www.wired.com/news/politics/0,1238,31551,00.html is attachment 6.

⁷A copy of the printout from www.netsol.com's WHOIS search engine for www.PerformanceBike.com is attachment 7.

compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that such evidence, if and when it becomes available.

All of the above listed physical evidence is contradictory to the assertions provided in the examiner's declaration as to the date of existence of the PerformanceBike.com web site (i.e., in 1994), and to the assertion that the web site is legal prior art to claims in this application.

Furthermore, the examiner has made "blanket statements" in his declaration that each and every limitation claimed in claims 32-70 were known to him prior to December 1996. Those statements are not supported by any specificity. The examiner's blanket statements in his declaration that each and every limitation claimed in claims 32-70 were known to him prior to December 1996 - - almost a decade ago - - are objectively implausible. Moreover, the existence of such blanket statements without providing any specificity as to any specific time, place, and observations, objectively indicates a lack of consideration of the seriousness involved in giving a declaration subject to penalty of perjury. For the foregoing reasons, I submit that the existence of the blanket statements undermines the examiner's credibility as to any facts asserted in his declaration and specifically including the date of timewise availability of the performancebike.com web site.

In deciding whether the examiner has made a prima facie case as to timewise availability of the performancebike.com web site, the APJ's must compare the weight of the physical evidence indicating that the web site did not exist until 1997 to the examiner's unsupported recollection that the web site existed in 1994 -- almost a decade ago. I submit that the examiner's unsupported recollection is clearly outweighed by the weight of the physical evidence and the information Mr. Ruggieri passed along to me. Accordingly, the APJs should conclude that the burden of the evidence indicates that the performancebike.com web site is not timewise available as prior art.

iv. The PerformanceBike.com Web Site Did Not In Fact Anticipate Any One of Claims 32-70

The applicants point out that the PerformanceBike.com web site does not now and did not in 1997 distribute incentives for in-store use, contrary to the examiner's assertion. A copy of printouts of pages of the PerformanceBike web site obtained from the WAYBACK MACHINE's

archive of the www.performancebike.com web site for 1997 is attachment 8. Note the copyright date on the front page of attachment 8 is 1997. Attachment 8 shows a web site which has none of the functionality claimed in the pending claims. None of those pages disclose or appear to provide incentives for in store use.⁸ It is highly unreasonable to assume that performancebike.com launched a web site with advanced functionality that provided incentives for in-store use as defined in the pending claims prior to 1996, at the beginning of the World Wide Web, and then removed all of that functionality prior to 1997. Accordingly, there is highly probative evidence that the teachings upon which the examiner asserts existed in the performancebike.com web site did not exist prior to 1997, i.e., did not exist prior to the priority date for the claims in this application. For this additional reason, the rejections based upon the examiner's declaration should be reversed.

v. The Examiner's Assertions Are Contradictory and not Specific as to Observed Activity, Place, and Time

The examiner's assertions in support of the 35 USC 103 rejections in the office action dated November 22, 2002 are contradictory. The examiner asserts in his declaration that the PerformanceBike.com web site disclosed the claimed inventions, by stating that:

Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selections data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

⁸A copy of the printout of 8 pages of the PerformanceBike.com web site from 1997, as stored in the WAYBACK MACHINE is attachment 8.

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and
generating a purchase incentive based on said discount items. [Office action dated 11/22/02 page 6 line 13 through page 7 line 11.]

However, the examiner corresponds claimed limitations to non-web site structure in a retail store, including (1) an in-store red courtesy phone, (2) a frequent buyer card, and (3) discounts associated with products in the retail outlet store.

A red courtesy phone does not describe or suggest the claimed "displaying," or "main" or "personal" computer.

Ordering from a red courtesy phone does not disclose or suggest any one of the claimed steps of transmitting or selecting of incentives, or generation, transmission or use of tokens.

In contrast to an "in store red courtesy phone", a personal computer has a memory capable of computing and with digital input and output ability. The in store red courtesy phone is not a computer, has no memory, cannot download or upload digital data files, let alone print purchase incentives. Accordingly, a red courtesy phone does not correspond to the claimed personal computer.

Moreover, no claim limitations respond to the steps of a person going into a retail store and viewing discounted products from a sales catalog, using a frequent buyer card during a purchase, or using frequent buyer points. Therefore, the examiner's reliance upon the performancebike.com web site as suggesting the claimed invention is both inconsistent and logically improper. Thus, the examiner's assertions are irrelevant to the claimed invention. Therefore, the rejections that rely upon those assertions should be reversed.

Finally the examiner's assertions are not backed up by any specificity. No specific time, place, or event is alleged in the examiner's declaration. Specificity is an important factor in determining probative value of any statement. "The lack of specificity deprives the appellant of a suitable rebuttal and makes the rejection vague and uncertain on review. Absent sufficient findings, it cannot be said that the examiner has sufficiently made out a prima facie case of

obviousness.” *Ex parte Marckini* (Appeal No. 97-3671, Application 08/266,977 at <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd973671.pdf> at page 9) (not binding precedent). Furthermore, the examiner has the burden to establish a prima facie case of obviousness. The examiner is required to establish a factual basis to support obviousness conclusion. *In re Fine*, 837 F.2d 1071, ___, 5 USPQ 2d 1596, 1988. Since the examiner has not provided specificity as to time, place, and event of any relevant prior public use, and since the examiner has not provided a meaningful explanation of the allegedly relevant performancebike.com web site's teachings, the rejections should be reversed.

For all the foregoing reasons, the rejections based upon the examiner's declaration are improper and should be reversed.

5. **37 CFR 1.192(c)(8)(v) - Other Rejections**

a. **The Rejection of Claims 32-70 under the Judicially Created Doctrine of Obviousness-type Double Patenting as Being Unpatentable over Claims 1-3 of Us Patent No. 5,970,469 or Claims 1-10 of Us Patent No. 6,185,541**

The examiner rejects claims 32-70 under the judicially created doctrine of obviousness-type double patenting, stating that:

Claims 32-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim of encoded [sic] ('469 patent) is an obvious variation of the application claimed token [sic] and the patented claimed [sic] advisory message ('541 patent) is an obvious variation of the application claimed general purchase incentive because both perform the same function in the same manner with the same result. [Office action mailed 11/22/02 page 9 line 9-15.]

In reply, the applicants traverse the rejections based upon US 5,970,469's claims. Those claims define transmitting purchase incentives associated with recipes, whereas the present claims define identifying token data in a retail store for generating purchase incentives. One would not have been obvious in view of the other. Therefore, the rejections based upon claims 1-3 in U.S. Patent No. 5,970,469 are improper and should be reversed.

The applicants also traverse the rejections based upon claims 1-3 in US 6,185,541. Those

**16. Item 16 - 35 USC 103(c) Rejection of Claims 32-58 Based Upon (1)
Examiner's Alleged Personal Knowledge and (2) the
www.PerformanceBike.com Web Site**

In item 16; the examiner rejects claims 32-58 under 35 USC 103(a). The examiner states
that:

Claims 32-58 are rejected under 35 U.S.C. 103(a) as being unpatentable
over an obvious variation of examiner's personal knowledge of consumer
purchasing incentive distribution provided by PerformanceBike.com (hereinafter
PerformanceBike). Since at least 1994, PerformanceBike has performed the
claimed method and system of:

- a web site for providing purchasing incentives from multiple sources;
- a consumer purchase history database based on consumer online shopping
activating;

- a consumer database which can identify consumers by their addresses,
wherein said consumer database is connected to said website so as to receive
consumer data from said web site; and any one of

- means for delivering purchasing incentives or web site visit notices to
consumers;

- means for delivering notices to purchase a specific manufacturer's
product;

- transmitting purchase incentives or web site visit notices via a post office;
and

- means for or a method informing of new incentives or printing coupons.

Examiner also has personal knowledge of consumer profile basis, purchase history
database either by an independently administered or cooperative site, and where
purchase history includes data based on past purchasing activity. The claimed
web site for providing purchasing incentives from multiple sources occur when
the examiner went into a PerformanceBike retail outlet store, web site or kiosk
and viewed discounted products from a sales catalog. The claimed consumer
purchase history database based on consumer online shopping activating occurs
when the examiner became a member of Team Performance which is a frequent
buyer program and submitted demographic data. The claimed consumer database
which can identify consumers by their addresses, wherein said consumer database
is connected to said website so as to receive consumer data from said web site
occurs when examiner submitted data to associate the PerformanceBike web site
to receiving shopping information. The claimed steps including means for
delivering purchasing incentives or web site visit notices to customers, means for
delivering notices to purchase a specific manufacturer's product, transmitting
purchasing incentives or web site visit notices via a post office, and means for or a

method informing of new incentives or printing coupons were administered by Performance Bike through sale mailings which included coupons of products available either at the retail outlet or web site. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the claimed e-mail notification. It would have been obvious to one skilled in the art to provide the claimed e-mail notification since e-mail is merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities through electronic mail mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention. [Office Action mailed 1/21/03 page 9 line 11 - page 11 line 13.]

In reply, the applicants respectfully traverse these rejections because they fail to carry the burdens of proof and persuasion, particularly in view of additional evidence submitted herewith.

The examiner alleges based upon personal knowledge the existence of the PerformanceBike.com web site of "[s]ince at least 1994." This allegation, even though asserted now by the examiner in a declaration, fails to carry the burden of proof as to the existence of the PerformanceBike.com web site prior to the applicant's priority filing date, i.e., prima facie date of invention of December 23, 1996.

a. No Physical Evidence Supports the Examiner's Decision

That applicant first points out that there is no physical evidence supporting the examiner's assertions. In fact, the PerformanceBike.com website printout enclosed with the July 29, 2002 office action shows a copyright year of 2000, which is the prima facie date associated with that website. Accordingly, no physical evidence supports the examiner's assertion that the PerformanceBike.com web site was prior art.

b. **Probative Evidence Exists That The PerformanceBike.com Web Site Did Not Exist In 1994**

Submitted with this response is probative physical evidence that the www.PerformanceBike.com web site did not exist until some time in 1997, and certainly no earlier than December of 1996.

i. **The Web Master for PerformanceBike.com Indicated That the First PerformanceBike.com Web Site Was Launched in Late 1996**

I spoke with the web master of performance bike on 9/19/02, via telephone. The web master is Andrew Ruggeri, telephone number 800-433-1633 (at an internal company extension of that number). Mr. Ruggeri clearly indicated to me (1) that he knew that the first web site for Performance Bike was launched in *August or September of 1996*, (2) that he became an employee of Performance Bike in 1997, and (3) that he knew that the Performance Bike web site has never provided coupons for retail store purchases. Mr. Ruggeri indicated that one reason the web site has never provided coupons for retail store purchases was that the pricing structure for web based sales and retail store sales were different, and therefore, placing incentives for retail store purchase on the website would be incompatible with the distinct pricing for web site sales and retail store sales.

I attempted to get a declaration from Mr. Andrew Ruggeri, but his company referred me to its outside IP counsel, Christopher Bolen, Esq., and Mr. Bolen refused my requests. Third party discovery is not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that evidence, if and when it becomes available.

ii. **Physical Evidence Indicates That The PerformanceBike.com Web Site Came into Existence in Late 1997**

A ten-page printout at URL www.archive.org/about/about.php describing the

WAYBACK MACHINE is submitted herewith.² A five page printout of the URL www.archive.org is submitted herewith.³ A two page printout of the URL pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 is submitted herewith.⁴ As indicated in those attachments, www.archive.org is run by the "Internet Archive", which is a non profit library organization dedicated to archiving the Internet. The Internet Archive has been receiving data regarding the web from "Alexa", which is a company that runs a 'web crawler.' A web crawler is a system that downloads and reviews all of the high level URLs for content on a periodic basis, for indexing their content for use by search engines.

The WAYBACK MACHINE is a web enabled interface between the Internet Archive's data store that enables anyone with a web browser to see what web sites looked like on prior dates. See attachment 2.

Moreover, the Director has instructed the examiners to rely upon the Wayback Machine to prove web site prior art dates. The USPTO hosted a "Business Methods Partnership Meeting" on April 1, 2003, which was open to the public. At this meeting, Jim Trammell, Supervisory Patent Examiner, TC 3600, and Bob Weinhardt, Quality Assurance Specialist, TC 3600, made the presentation "When is an Electronic Document a Printed Publication for Prior Art Purposes?"⁵ The presenters in particular identified the "Wayback Machine" as among the "Resources Used by Examiners to Establish Website Dates."⁶ The presenters stated that the Wayback Machine "[f]inds archived web pages back to 1996."⁷ The presenters made it quite

²A copy of the ten page printout of www.archive.org/about/about.php is attachment 1.

³A copy of the five page printout of www.archive.org is attachment 2.

⁴A copy of the two page printout of pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 is attachment 3.

⁵A Copy of the presentation "When is an Electronic Document a Printed Publication for Prior Art Purposes?" is attachment 12. This presentation was made as part of the USPTO's "Business Methods Partnership Meeting" with the public, held April 1, 2003.

⁶Slide 25 from Attachment 12.

⁷Slides 27-29 from Attachment 12.

clear that the USPTO's examiners are relying on Wayback Machine archive dates as evidence showing prior art dates for websites. Thus, the applicants use of the Wayback Machine herein should be accorded equal respect.

I used the WAYBACK MACHINE to see which versions of the PerformanceBike.com web site existed at prior dates. Specifically, I used the WAYBACK MACHINE's search function for <http://performancebike.com> November 27, 2002. My results are attachment 4.⁸ The search result shows that PerformanceBike.com web site was not launched until October 1997. Specifically, attachment 4 states "0 pages" under the heading 1996, which strongly suggests that, although the URL domain name was registered with the domain name register in 1996, no web pages were associated with the logical address www.PerformanceBike.com that could be downloaded to a user's computer via use of a web browser until after 1996. In contrast, attachment 4 shows web pages associated with www.PerformanceBike.com beginning October 17, 1997, and web pages continuously associated with that URL ever since. This evidence implies that the www.PerformanceBike.com web site, that is, a URL which would transmit web pages to a user, did not exist prior to the priority filing date for this application.

I attempted to get a declaration from a representative of the Internet Archive. However, their representative referred me to their counsel, which is Rachel Silvers of the firm of Perkins Coie LLP in San Francisco. Ms. Silvers indicated that the Internet Archive refused to provide a declaration explaining the meaning of the "1996 0 pages" text in attachment 4. Third party discovery is not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that evidence, if and when it becomes available.

iii. **The www.PerformanceBike.com Domain Name Was Not Even Registered Until December 3, 1996**

Network Solutions, Inc. was founded in 1979 and is located in Herndon, Virginia. Until recently, in 1999, Network Solutions, Inc. was the only registrar of domain names for the web.

⁸A copy of the printout of the WAYBACK MACHINE'S search result for <http://performancebike.com> conducted on November 27, 2002 is attachment 4.

www.netsol.com is Network Solutions, Inc.'s web site.⁹ It contains a WHOIS search engine.

This type of search engine provides users information related to a particular web site, such as registrant name, date of initial registration, and date of most recent update.

I conducted a search for www.PerformanceBike.com on the WHOIS search engine at www.netsol.com on December 2, 2002. A printout of the WHOIS search result for www.PerformanceBike.com from www.netsol.com WHOIS search engine is submitted herewith as attachment 7.¹⁰ The search result shows that the domain name www.PerformanceBike.com was not registered December 3, 1996.

When a domain name is registered, it is by contract, controlled by the entity that purchased it. It does not automatically have web pages, i.e., a web site, associated with it. Therefore, the mere fact that www.PerformanceBike.com was registered on December 6, 1996, does not imply that a web site, i.e., content available for downloading to a user's browser, existed on that date. In fact, complicated web sites often take months to develop before they are ready for loading onto the web as a web site.

I attempted to get a declaration from a representative of NSI explaining that the date listed in their WHOIS search engine is the date that a domain name was first registered in the master Domain Name Service hosted by NSI and therefore the earliest date on which the domain name would have been available for hosting a web site.

A representative of NSI verbally indicated to me that NSI only accepted subpoenas for testimony via FAX, and that NSI did not respond to voluntary requests for discovery. Third party discovery is not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this appeal with that evidence, if and when it becomes available.

⁹A copy of the two page printout from www.verisign.com/corporate/news/apr_19980107.html describing Network Solutions, Inc., is attachment 5. A copy of the two page www.wired.com/news/politics/0,1238,31551,00.html is attachment 6.

¹⁰A copy of the two page printout from www.netsol.com's WHOIS search engine for www.PerformanceBike.com is attachment 7.

c. **The Weight of the Evidence is that the PerformanceBike Web Site did not Exist in 1994**

All of the above listed physical evidence is contradictory to the assertions provided in the examiner's declaration as to the date of existence of the PerformanceBike.com web site, and to the assertion that the web site is legal prior art.¹¹ The APJs must compare the weight of the physical evidence indicating that the web site did not exist until 1997 to the examiner's recollection that the web site existed in 1994. I submit that the examiner's unsupported recollection is clearly outweighed by the weight of the physical evidence and the information Mr. Ruggieri passed along to me.

d. **Objectively Implausible Nature of Factual Assertions in the Examiner's Declaration**

The examiner made blanket statements in his declaration that each and every limitation claimed in claims 32-58 were known to him prior to December 1996. In fact, the examiner has made the same type of blanket statement in rejecting all claims in attorney docket CAT/29US-SCROCO, application number 09/401,939, which is also now on appeal. The examiner's allegations that so many limitations in so many claims were personally known to him are objectively implausible. For this reason, the examiner's declaration should be given little or no probative weight.

e. **The PerformanceBike.com Web Site Did Not In Fact Anticipate or Suggest Any One of Claims 32-58**

The applicants point out that the PerformanceBike.com web site does not now and did not in 1997, distribute incentives for in-store use, contrary to the examiner's assertion. A copy of printouts of pages of the PerformanceBike web site obtained from the WAYBACK MACHINE's archive of the www.performancebike.com web site is attachment 8. That archive shows a web site which has none of the functionality defined in the pending claims. None of those pages disclose or appear to provide incentives for in store use.¹² Accordingly, to the extent the

¹¹ A copy of the 3 page examiner affidavit supporting obviousness rejection from Application no. 09/401,939 office action mailed November 22, 2002 is attachment 9.

¹² A copy of the printout of 8 pages of the PerformanceBike.com web site from 1997, as stored in the WAYBACK MACHINE is attachment 8.

examiner relies upon his memory for recollection of web site based incentives, the rejections of claims 32-58 are improper and should be withdrawn.

For all the foregoing reasons, the rejections based upon the examiner's declaration are improper and should be withdrawn.

The examiner corresponds claimed limitations to non-web site structure appearing in a retail store or a kiosk, or viewing discounted products residing in the retail outlet store.

Furthermore, the examiner asserts that:

The claimed web site for providing purchasing incentives from multiple sources occur when the examiner went into a PerformanceBike retail outlet store, web site or kiosk and viewed discounted products from a sales catalog. [Office Action mailed 1/21/03 page 10 lines 6 - 8.]

In reply, the applicants disagree because the examiner's reliance upon the Performancebike.com web site as suggesting the claimed invention is logically improper.

There are no features claimed related to going into a retail store or a kiosk or viewing discounted products from a sales catalog. Thus, the examiner's rejection is irrelevant to the present invention and should be withdrawn.

f. Obviousness Rejections Based on the Examiner's Declaration

The examiner asserts that:

Furthermore examiner experience teaches the claimed invention except for the claimed e-mail notification. It would have been obvious to one skilled in the art to provide the claimed e-mail notification since e-mail is merely an automated feature of a concept that is old and well known as discussed above. [Office Action mailed 1/21/03 page 11 lines 4 - 7.]

In reply, the applicants disagree because the mere fact that the prior art that the examiner declared he "experienced" via PerformanceBike.com could be modified would not have made the modification obvious, absent some teaching in the prior art motivating the modification of the prior art. In re Deminski, 796 F.2d 436, 230 USPQ 3113 (Fed. Cir. 1986).

Moreover, the web site provides no teaching suggesting incentives distributed over the Internet. Therefore, the rejections relying upon the examiner's experience of the PerformanceBike.com web site are improper and should be withdrawn.

Art Unit: 3622

the independent claims further the patentable distinction of the Scroggie claims from Golden. Because Scroggie recites a personal web page feature, independent claims 1, 14, and 27 are patentably distinct from Golden.

Jovicic does expressly or inherently teach the independently claimed step of *determining or a main computer configured to determine a purchase incentive depending on (1) said product data stored in said purchase history database or (2) said page data stored in said personal page data base and updating or a main computer configured to update said page data so that said personal web page will display said purchase incentive*. The independently claimed *purchase incentive depending on product data stored in said purchase history database or page data stored in said personal page database and page data updating* is patentably distinct from Jovicic because the purchase incentive or coupon depends on "product data" or "page data," which is further updated, neither of which is expressly or implicitly taught in Jovicic. At column 3 lines 1-16, Jovicic discusses a coupon distribution and redemption system based on already obtained demographic data. Scroggie's purchase incentive depending on product data or page data and further updating page data is not equivalent to a coupon distribution and redemption system based on already obtained demographic data taught in Jovicic. Scroggie is patentably distinct from Jovicic because the purchase incentive variability depends upon product data and page data while the page data variability depends upon updated page data. This two-tiered level of purchase incentive variability (the product data and page data factors being the first-tier and the updated page data factors being the second-tier) is not expressly or inherently found in Jovicic. Because

When is an Electronic Document a Printed Publication for Prior Art Purposes?

**for the
Business Methods Partnership Meeting**

April 1, 2003

by

**Jim Trammell
Supervisory Patent Examiner**

TC 3600

**Bob Weinhardt
Quality Assurance Specialist**

TC 3600

Attachment 12

The Evolution of Prior Art

- ◆ Both U.S. and foreign patents have, in the past, been relied upon as the primary form of prior art during the examination process
- ◆ However, in some emerging technology areas (like business methods), examiners must now rely heavily on non patent literature (NPL), especially those in electronically searchable databases.
 - To ensure that the appropriate electronically searchable databases were being used by the Class 705 examiners, a Federal Register notice was published in June, 2001 listing core NPL databases searched by the examiners and asking for public comment.

The Challenge of Prior Art

- ◆ Examiners can have difficulty identifying a claimed invention as one that may have been common practice or common knowledge in a given industry, since that claimed invention may not have been documented properly, dated properly, or disclosed in a form that is easily accessible by patent examiners.
- ◆ This is changing through communications and partnerships with industry.
 - In the business methods workgroup, we have partnerships with approximately 40 industry and patent practitioner contacts, many of whom have provided training on previously un-documented industry-specific common practices.

The Challenge of Prior Art

Rule 105 is also helpful to examiners in understanding a given invention and creating search strategies.

- Rule 105 (37 C.F.R. 1.105(a)(1)) states that:
" ...the examiner or other Office employee may require the submission...of such information as may be reasonably necessary to properly examine or treat the matter..."
- Designed to get more relevant information into the record faster using information available to the applicant

§ 1.105 - Request for Information

Example Requirements Related to Electronic Documentation

Examples of information that can be required:

- **Commercial Databases**: The examiner can request that applicant provide a list of any known relevant commercial database(s) that could be searched for a particular aspect of the invention.
 - A common use of Rule 105 in business methods
- **Search**: The examiner can request that applicant identify any prior art searches made.
- **Related Information**: The examiner can request that applicant provide a copy of any non-patent literature (NPL), or information on a published application, or patent (U.S. or foreign), that:
 - relates to the claimed invention,
 - was used to draft the application, or
 - was used in the invention process.

Third Party Submission

37 CFR 1.99

Another tool that can help an examiner identify relevant prior art is the third party submission under 37 CFR 1.99.

- ♦ A member of the public may submit patents or publications relevant to a pending published application in accordance with 37 CFR 1.99
- ♦ These submissions may be entered in the application file if the requirements of the rule are complied with. The submission must be within two months of the publication date, or prior to the mailing of a notice of allowance whichever is earlier.

Electronic Publications

An electronic publication, like any publication, may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP 2121.01, 2123 and 2128.01.

Printed Publications *Past to Present*

A reference is a printed publication if it is *accessible* to the public.

- ♦ A reference is proven to be a “printed publication” “upon a satisfactory showing that such document has been disseminated **or** otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981).

However, “Printed” is No Longer the Definitive test for “Publication”

“Given the state of technology in document duplication, data storage and data systems retrieval, the ‘probability of dissemination’ of an item very often has little to do with whether or not it is ‘printed’ in the sense of that word when it was introduced into the patent statutes in 1836.” *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981).

**Instead, Public Accessibility is the
Key for Electronic Publications**

Electronic Publications

An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 102(a) and (b) provided the publication was *accessible* to persons concerned with the art to which the document relates. See *In re Weyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981).

Public Accessibility

Thus, "whether information is printed, handwritten, or on microfilm or magnetic disk or tape, etc., the individual who wishes to characterize the information as a printed publication...should produce sufficient *evidence of its dissemination* or that it has been otherwise *available and accessible* to persons concerned with the art to which the document relates..." *In re Wyer*, 655 F.2d at 227, 210 USPQ at 795, *Amazon.com v. Barnesandnoble.com*, 73 F. Supp. 2d 1228, 53 USPQ 2d 1115, 1119 (W.D. Wash. 1999)

Be Careful

In situations where the electronic version and the published paper version of the same or corresponding document differ appreciably, each version may need to be cited and relied upon as independent references based on what they each disclose. See MPEP 2128.

Internet and Database Prior Art

Prior art disclosures on the Internet or in an on-line database are considered to be publicly available as of the date the item was publicly posted.

- The item must be dated and not temporal
- The item must be accessible to the public (e.g., indexed for subsequent retrieval).

Thus, the Rules are the Same

Regardless of whether the prior art is in an electronic or printed form, the rules governing the use of the prior art are the same.

- There still must be a satisfactory showing that the document(s) have been disseminated or otherwise made available to persons with interest and ordinary skill in the art.

Example

Thus, documents distributed internally within an organization, which are intended to remain confidential, are not “printed publications,” just as an internal confidential website available only to specific users may not qualify as prior art.

Example (cont)

However, documents downloaded from an online database or website that was available for only a limited time may be considered prior art if an adequate showing is provided that the database or website was properly dated, and publicly accessible at the time of document retrieval.

Temporal Example

A web broadcast that cannot be saved, retrieved or printed.

- Live simulcast feed that is not archived
- Streaming audio or video that “flashes” across the screen

Showing Accessibility

The Office policy requiring recordation of the field of search and search results weighs in favor of finding that Internet and on-line database references cited by the examiner are "accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents." *In re Weyer*, 655 F.2d at 221, 210 USPQ at 790.

Showing Accessibility

Office copies of an electronic document must be retained if the same document may not be available for retrieval in the future. This is especially important for sources such as the Internet and online databases. MPEP 2128.

The Examiner Must Make a *Prima facie* Showing

By showing that an electronic publication was properly dated, retrievable and accessible to the public, the examiner has made a *prima facie* case that the electronic publication qualifies as prior art. The burden now shifts to applicant to prove otherwise.

Websites as Prior Art

Websites can be used as references if posting dates can be found, and these posting dates predate the invention.

Software Products as Prior Art

Software products can be relied upon as prior art as of the date they were first installed or released.

In re Epstein,

32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994)

Database printouts of abstracts which were not themselves prior art publications were properly relied as providing evidence that the software products referenced therein were "first installed" or "released" more than one year prior to applicant's filing date.

Public Use or On Sale Bar

(35 U.S.C. 102(b))

- ♦ An invention is in “public use” if that invention is publicly used without restriction or obligation of secrecy. This applies to Internet and on-line database references.
- ♦ A single sale or offer to sell the invention may constitute a bar to patentability. Again, this applies to Internet and on-line offers to sell, if publically accessible.

Resources Used by Examiners to Establish Website Dates

- ◆ Commercial Databases
- ◆ Wayback Machine

Commercial Databases

Commercial Databases are often used by Examiners to discover dates for websites.

- Articles from a database can be used to provide the date of the website
 - If the date of the article is the only date information available, then the website date is the article date.
 - If other relevant date information about the website is disclosed in the article, then that relevant information can be used to date the website.

Wayback Machine

- ◆ www.archive.org
- ◆ Finds archived web pages back to 1996.
- ◆ Each archived page is dated.
- ◆ Covers many, but not all, web pages.

Find archived pages for: <http://attrasoft.com>



The Internet Archive: Building an 'Internet Library'

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The Internet Archive is building a digital library of Internet sites and other cultural artifacts in digital form. Like a paper library, we provide free access to researchers, historians, scholars, and the general public in accordance with our Terms of Use.

INTERNET ARCHIVE

WaybackMachine

Surf the Web as it was

<http://attrasoft.com/>

Take Me Back

The Internet Archive, working with Alexa Internet, has created the Wayback Machine. The Wayback Machine makes it possible to surf pages stored in the Internet Archive's web archive. The Wayback Machine was unveiled on October 24th at Berkeley's Bancroft Library. Visit the Wayback Machine by entering an URL above or clicking on specific collections below.

Enter Web Address:

Searched for <http://attrasoft.com/>

66 Results

Note some duplicates are not shown. See [all](#).
* denotes when site was updated.

Search Results for Jan 01, 1996 - Mar 14, 2002					
1996	1997	1998	1999	2000	2001
0 pages	17 pages	5 pages	12 pages	15 pages	10 pages
	Dec 24, 1997 *	Feb 04, 1998 May 06, 1998 * Dec 05, 1998 * Dec 06, 1998 Dec 12, 1998 *	Jan 25, 1999 * Feb 08, 1999 Feb 18, 1999 Feb 24, 1999 * Feb 24, 1999 * Feb 24, 1999 * Feb 25, 1999 Apr 21, 1999 * Apr 27, 1999 * May 07, 1999 * Oct 12, 1999 * Nov 22, 1999 *	Feb 29, 2000 * Mar 03, 2000 * Mar 04, 2000 May 10, 2000 * May 11, 2000 May 20, 2000 Jun 12, 2000 Jun 19, 2000 Aug 17, 2000 * Sep 01, 2000 Oct 17, 2000 * Oct 18, 2000 Oct 19, 2000 * Dec 06, 2000 * Dec 17, 2000	Jan 18, 2001 * Feb 01, 2001 Feb 03, 2001 * Mar 01, 2001 * Mar 02, 2001 Mar 31, 2001 * May 16, 2001 Jun 30, 2001 Jul 20, 2001 Sep 22, 2001 *
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Other Sources of Public Input

- ◆ The business methods area will occasionally receive search resources provided in hard copy from the public i.e. in the form of books, trade journals, training guides and other non-patent literature.
- ◆ These resources are evaluated for relevance to the business methods area, and if found relevant, cataloged and made available in the EIC for the examiners to consult.
- ◆ The cataloging of these materials includes referencing the title, author and short summary of the materials in an electronic digest located on the patent intranet NPL virtual library which is available only internally to patent examiners.

Conclusion

- ◆ In addition to the traditional sources of prior art, examiners are now focusing on electronically searchable databases and other forms of NPL to examine patents in emerging technology areas such as business methods
- ◆ The PTO has provided the tools and the resources to search hundreds of NPL sources
- ◆ The courts have provided guidelines on how some NPL is to be treated
- ◆ Refer to MPEP Chapter 2100 for more detailed instruction regarding use of prior art



The End

Thank You